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IN THE

Supreme Court of the United States

OCTOBER TERM, 1983

PIHER INTERNATIONAL CORPORATION and PIHER SOCIEDAD ANONIMA,

Petitioners,

v.

CTS CORPORATION,

Respondent.

PETTTION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

RAIFORD A. BLACKSTONE, JR.*
RICHARD R. TREXLER
TREXLER, BUSHNELL & WOLTERS, LTD.
141 West Jackson Boulevard
Chicago, Illinois 60604
(312) 427-8082

Attorneys for Petitioners

* Counsel of Record

Midwest Law Printing Co., Chicago 60611, (312) 321-0220

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QUESTIONS PRESENTED FOR REVIEW

Bearing in mind that the particular court of appeals below (the recently-created "CAFC") has *exclusive* jurisdiction of appeals involving the statute in question herein, and that the *sole* purpose of the statute is to protect the public's, in the words of this Court in *Precision Instrument, infra* page 4, "paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope"; the principal questions presented for review are:

1. Did the court of appeals effectively repeal a federal statute (35 U.S.C. Section 135(c)), which statute was enacted by Congress for the purpose of codifying the broad public policy, anticompetitive considerations set forth by this Court in *Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co., infra* page 4?

2. Did the court of appeals err, as a matter of law, by construing 35 U.S.C. Section 135(c) in a manner contrary to the clear language of the statute, contrary to the expressed legislative intent behind the statute, and in a manner that clearly conflicts with this Court's decisions regarding statutory construction and interpretation in *Consumer Products Safety Commission v. GTE Sylvania, infra,* and *Commissioner v. Brown, infra* pages 14-15?

3. Did the court of appeals, by its adding to the statute the nebulous "causal connection" requirement (which requirement is neither present nor even remotely suggested whatsoever anywhere in the statute or its legislative history), so severely narrow the scope of Section 135(c)

that few, if any, settlement agreements need ever be filed in the Patent Office, which means that the United States Department of Justice will rarely, if ever, be able to perform its duty to the public under this statute?

4. More specifically, did the court of appeals err in concluding that, as a matter of law, although a settlement agreement expressly refers to a pending patent interference as one of the matters being settled, it somehow does *not* fall within the scope of the statute, notwithstanding the fact that the statute, by specific legislative intent, clearly and plainly states that its scope includes:

> "*any* agreement or *understanding* between the parties to an interference, including *any collateral* agreements referred to therein, made in *connection with* or in *contemplation of* the termination of the interference, . . ." (emphasis added)?

PARTIES TO THE PROCEEDING

In compliance with Supreme Court Rule 21(b), the parties to the proceeding in the court whose judgment is sought to be reviewed are identified as those listed in the caption of the case in this Court.

TABLE OF CONTENTS

QUESTIONS PRESENTED FOR REVIEW .. i

PARTIES TO THE PROCEEDING ii

TABLE OF AUTHORITIES iv

OPINIONS DELIVERED IN THE COURTS BELOW 1

JURISDICTION 2

THE STATUTE INVOLVED 2

STATEMENT OF THE CASE 3

A. Basis For Federal Jurisdiction Below . 3

B. The Statute 3

C. The Settlement Agreements Herein ... 8

D. The Interference 9

E. Disposition In The Court Below 9

ARGUMENT 11

A.

THE COURT OF APPEALS' DECISION EFFECTIVELY REPEALS 35 U.S.C. SECTION 135(c) . 11

B.

THE COURT OF APPEALS CONSTRUED THE STATUTE IN A MANNER CONTRARY TO THE CLEAR LANGUAGE OF THE STATUTE 13

C.

THE COURT OF APPEALS' CONSTRUCTION OF THE STATUTE IS CONTRARY TO THIS COURT'S GUIDELINES 14

D.

THE COURT OF APPEALS' CONSTRUCTION OF THE STATUTE IS CONTRARY TO PRIOR CASE LAW 15

CONCLUSION 16

APPENDIX

A— 35 U.S.C. § 135(c) A-1

B— Opinion of the United States Court of Appeals for the Federal Circuit B-1

C— Memorandum Decision of the United States District Court C-1

D— Excerpt of Proceedings from the United States District Court D-1

E— Legislative History E-1

TABLE OF AUTHORITIES

Cases

Cinerama, Inc. v. Sweet Music, S.A., 482 F.2d 66 (2d Cir. 1973) 3

Commissioner v. Brown, 380 U.S. 563 (1965) .. 14

Consumer Products Safety Commission v. GTE Sylvania, 447 U.S. 102 (1980) 14

CTS v. Piher, 219 U.S.P.Q. 1180 and 219 U.S.P.Q. 1177 (N.D. Ill. 1984) 1

CTS v. Piher, 727 F.2d 1550, 221 U.S.P.Q. 11 (C.A.F.C. 1984) ..... *passim*

Esso Research v. Brenner, Comr. Pats., 425 F.2d 270, 165 U.S.P.Q. 486 (D.C. Cir. 1970) 11, 16

Moog, Inc. v. Pegasus Laboratories Inc., 521 F.2d 501 (6th Cir. 1975) 11, 15, 16
Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806; 65 S.Ct. 993; 89 L.Ed. 1381 (1945) 4
United States v. FMC Corp., 514 F.Supp. 1166 (E.D. Pa. 1981) 6
United States v. FMC Corporation, 215 U.S.P.Q. 43 (E.D. Pa. 1982), reversed on other grounds, 717 F.2d 775 (3rd Cir. 1983) 11, 12

Statutes

Title 28, United States Code, Section 1254(1) .. 2
Title 28, United States Code, Section 1295(a) .. 3, 13
Title 28, United States Code, Section 2101(c) .. 2, 9
Title 35, United States Code, Section 135(c) .. *passim*
Title 35, United States Code, Section 146 9

Other

Rule 60(b)(6) of the Federal Rules of Civil Procedure 3, 9
House of Representatives Report No. 1983, 87th Congress, 2d Session 1 (1962) 6, 7
Senate Report No. 2169, 87th Congress, 2d Session, Reprinted in 1962 U.S. Code Cong. & Ad. News, 3286, 3289 ..... 5, 6, 7

In The

Supreme Court of the United States

October Term, 1983

PIHER INTERNATIONAL CORPORATION and PIHER SOCIEDAD ANONIMA,

Petitioners,

v.

CTS CORPORATION,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

OPINIONS DELIVERED IN THE COURTS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit, whose judgment is sought to be reviewed herein, was entered on February 17, 1984, and is reported at 727 F.2d 1550, 221 U.S.P.Q. 11 (Appendix B herein).

The District Court decision for which review was sought in the Court of Appeals, is reported at 219 U.S.P.Q. 1180 and 219 U.S.P.Q. 1177 (Appendix C herein).

Prior related litigation between the parties is identified in the court of appeals decision at 727 F.2d 1550, 1552-54 (Appendix pages B-3 through B-6 herein).

JURISDICTION

Jurisdiction of the Court is invoked under Title 28, United States Code, Section 1254(1).

This petition is being filed within the 90-day period permitted under Title 28, United States Code, Section 2101(c), from the entry of the decision by the Court of Appeals on February 17, 1984.

THE STATUTE INVOLVED

The more relevant portion of the statute involved in this Petition is as follows:

TITLE 35

Section 135, Interferences

* * *

"(c) Any agreement or understanding between the parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. . . . Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. . . ."[1]

[1] The complete text of 35 U.S.C. Section 135(c) is reproduced in the Appendix hereto at page A-1.

STATEMENT OF THE CASE

A. Basis For Federal Jurisdiction Below.

On January 25, 1982, the United States District Court for the Northern District of Illinois entered a Judgment Order pursuant to a settlement agreement between the parties hereto. One of the provisions of that Order provided for that district court to retain continuing jurisdiction of the subject matter and the parties for the purposes of assuring that the judgment was fully and completely discharged.

On January 14, 1983, the Petitioner herein ("Piher") filed a motion in the Illinois district court pursuant to Rule 60(b)(6) of the Federal Rules of Civil Procedure to modify the Judgment Order. The district court denied the motion and Piher appealed to the Court of Appeals for the Federal Circuit.

The appellate court based its jurisdiction on 28 U.S.C. Section 1295(a) (1982) and *Cinerama, Inc. v. Sweet Music, S.A.*, 482 F.2d 66, 71-72 (2d Cir. 1973) "(a denial of a Rule 60(b)(6) motion is final and appealable)" (727 F.2d 1555; Appendix p. B-9). The appeal was heard on November 10, 1983, and the court of appeals entered its decision on February 17, 1984, affirming the district court's denial of the Rule 60(b)(6) motion.

B. The Statute.

The function of 35 U.S.C. §135(c) is to enable the Justice Department to inspect "any" agreements or "understandings", and "any collateral agreements referred to therein", made "in connection with" or "in contemplation of" the termination of a patent interference to discover whether

or not such agreements or understandings contain any possible anticompetitive elements (Appendix p. A-1; 727 F.2d 1550, 1555-56; Appendix pp. B-9-10). This statute was enacted by Congress for the purpose of codifying the broad public policy, anticompetitive considerations as set forth by this Court in *Precision Instrument Manufacturing Company v. Automotive Maintenance Machinery Company*, 324 U.S. 806; 65 S.Ct. 993; 89 L.Ed. 1381 (1945), where the Court stated:

> "* * * The possession and assertion of patent rights are 'issues of great moment to the public' [citing cases]. A patent by its very nature is affected with a public interest. As recognized by the Constitution, it is a special privilege designed to serve the public purpose of promoting the 'progress of science and useful arts'. At the same time, a patent is an exception to the general rule against monopolies and to the right to access to a free and open market. The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope. The facts of this case must accordingly be measured by both public and private standards of equity." (324 U.S. 806, 815-16)
>
> * * *
>
> ". . . Those who have applications pending with the Patent Office or who are parties to Patent Office proceedings have an uncompromising duty to report to it all facts concerning possible fraud or inequitableness underlying the applications in issue. [citations omitted] This duty is not excused by reasonable doubts as to the sufficiency of the proof of the inequitable conduct nor by resort to independent legal advice. Public interest demands that all facts rele-

> vant to such matters be submitted formally or informally to the Patent Office, which can then pass upon the sufficiency of the evidence. Only in this way can that agency act to safeguard the public in the first instance against fraudulent patent monopolies. Only in that way can the Patent Office and the public escape from being classed among the 'mute and helpless victims of deception and fraud.' [citations omitted]" (*Id.* at 818).

The Department of Justice comments made during Senate considerations of Section 135(c) quoted the first paragraph of the above portion of this Court's decision in *Precision*, and then included the following statement:

> "The purpose of this legislation is to make it more difficult for patent applicants to use an interference settlement agreement as a means of violating the antitrust laws. It seeks to accomplish this purpose by providing that no such *agreement* or *understanding* shall be enforceable unless all of its terms are in writing and filed prior to the termination of the interference proceeding." S.Rept.No.2169, 87th Cong., 2d Sess., Reprinted in 1962 U.S. Code Cong. & Ad. News, 3286, 3289 (emphasis added).

But, according to the Justice Department, the above-quoted language was not sufficient. It went on to say:

> "It is our view that this prohibition would not adequately deter violations of the antitrust laws. It is therefor suggested that the measure be amended to provide that the parties to an interference settlement agreement shall be precluded from enforcing the resulting *patent* unless a copy of the settlement agreement has been filed with the Patent Office prior to the termination of the interference." (*Id.*, emphasis added)

The statute as enacted incorporated this additional request of the Justice Department.

In the Senate Report on this statute, the central purpose of the statute was recited as follows:

> "The purpose of this bill is to amend the patent laws to require the filing in the Patent Office of agreements settling patent interference proceedings. When two or more applicants claim substantially the same invention, an interference is declared in order to determine which applicant is entitled to priority. Interference proceedings may be terminated in a manner hostile to the public interest by using patent interference settlement agreements as a means of restricting competition. To make such a practice more difficult the bill requires the filing of such agreements in the Patent Office." *Id.* at 3286.

The House Report further emphasizes the purpose of the statute:

> "Recent experience has indicated that parties have sometimes used these interference proceedings in derogation of the public interest, in that interference settlement agreements have been entered into for the purpose of restricting competition . . . [T]he bill would make it more difficult for patent applicants and owners to use an interference settlement agreement as a means of secretly violating the antitrust laws." (H.R. Rept. No. 1983, 87th Cong., 2d Sess. 1 (1962); as quoted in *U.S. v. FMC Corp.*, 514 F.Supp. 1166, 1169 (E.D. Pa. 1981) reversed on other grounds, 717 F.2d 775 (3rd Cir. 1983)).

The importance of having a broad disclosure provision in Section 135(c) was well understood by the bill's sponsors. Representative Willis, who introduced the bill and chaired the House hearings, commented during the hearings on the extent of the disclosure required:

> "The bill in my view . . . would be meaningless if it didn't contemplate that the agreement filed, which

> you say would never disclose any antitrust features, should be the *whole agreement.* If that agreement is not the *total agreement,* that patent is possibly going to fall because you are defrauding the Government. You haven't set forth your *true agreement.* * * * In other words, if you say the parties are not going to disclose what their *true agreement* is anyway because then they would be convicting themselves of antitrust shenanigans, and implying that their *true agreement* would be a *side one,* I say to that that if you are not filing what you are *really agreeing to,* your patent is going to fall which would seem to me to be the proper construction" (H.R. Rep. No. 1983, 87th Cong., 2d Sess. 17 (1962), emphasis added).

Representative Tuck stated at those same hearings that "[t]he object of this bill is to bring *everything* out into the light and put *everything* in the report." (*Id.* at 11, emphasis added).

Finally, during the Senate hearings, the Commissioner of Patents at that time, David Ladd, was asked whether he thought the language of the bill was unclear regarding the types of agreements required to be filed. Commissioner Ladd responded:

> "As to clarity, it seems to me it is quite clear. It is *all* agreements in *contemplation* or in settlement of interferences." (S.Rept.No.2169, 87th Cong., 2d Sess., Reprinted in 1962 U.S.Code Cong. & Ad.News, 3286, 3289; emphasis added).

The statute includes not only "any agreement or understanding" but also "any collateral agreement referred to therein" made in "connection with" or in "contemplation of" the termination of the interference.

C. The Settlement Agreements Herein.

After years of litigation, the details of which are not particularly relevant here, management representatives of CTS and Piher met in Chicago on November 23, 1981, to discuss and settle the then-pending interference litigation (and other matters) between them (Appendix p. B-6). At the close of the meeting, CTS proposed a number of basic terms of settlement and gave Piher 24 hours to accept or reject them (*Id.*). Piher accepted these basic terms on the next day, November 24, 1981 (*Id.*). This agreement was reduced to writing on November 25, 1981; various minor changes were made in the written agreement; and the parties formally executed a copy of the agreement on December 10 (CTS) and December 16 (Piher) (*Id.*).

This settlement agreement expressly recited the fact that one of the litigation matters that the parties were settling was the interference (727 F.2d 1554; Appendix p. B-6).

Two collateral agreements referred to in the first agreement were prepared and executed by the parties on January 14, 1982. At least one of these collateral agreements expressly recited that the parties were "agree[ing] to terminate" the interference (727 F.2d 1554; Appendix pp. B-6-7).

The three settlement agreements formed the basis for the district court's entry of its judgment order on January 25, 1982.

None of the three settlement agreements were ever filed in the United States Patent and Trademark Office.

D. The Interference.

As found by the court of appeals (727 F.2d 1552-53; Appendix pp. B-3 through B-6), the interference litigation proceeded, via appeal pursuant to 35 U.S.C. Section 146, through the United States District Court for the Northern District of Indiana and the Seventh Circuit Court of Appeals. The Seventh Circuit rendered a decision adverse to Piher on November 4, 1981.

On November 18, 1981, a few days prior to the settlement meeting, Piher filed a Petition for Rehearing in the interference litigation before the Seventh Circuit Court of Appeals. On December 2, 1981, approximately a week after the settlement meeting and resulting agreement, the Petition for Rehearing was denied. Pursuant to 28 U.S.C. Section 2101(c), absent the settlement, Piher was then entitled to file a petition for Writ of Certiorari to this Court within 90 days thereafter; namely, by March 2, 1982.

The interference litigation was terminated, however, on January 25, 1982, when the district court entered its judgment order because that order by its terms effectuated the parties' agreement to settle the interference. Piher did not file a Petition for Writ of Certiorari.

E. Disposition In The Court Below.

In affirming the district court's denial of Piher's Rule 60(b)(6) motion, the court of appeals agreed with the district court's conclusion of law that, ". . . pursuant to Section 135(c), there must be a *causal relationship* between the agreements and the termination of the interference" (emphasis added). (727 F.2d 1556; Appendix p. B-11). Similarly, it agreed with the district court's holding that such a relationship was absent so that the settlement agreements need not have been filed in the Patent Office.

The court of appeals agreed with the district court's findings that there was no "causal relationship" for three reasons:

1. ". . . the possibility of filing a writ petition was not discussed at the November 23, 1981, settlement meeting, and thus, no causal relationship was shown." (727 F.2d 1556; Appendix p. B-12).

2. ". . . references to the interference in [settlement] documents A and B did not indicate a causal relationship between the settlement of the infringement and the termination of the interference." (727 F.2d 1557; Appendix p. B-14).

3. Although the settlement agreements recite the interference as one of the matters being settled, the agreements ". . . were not made in connection with or in contemplation of the termination of the interference." (727 F.2d 1557-58; Appendix p. B-14).

ARGUMENT

A.

THE COURT OF APPEALS' DECISION EFFECTIVELY REPEALS 35 U.S.C. SECTION 135(c).

By adding the "causal relationship" requirement to Section 135(c), the court of appeals has effectively repealed the statute because, relying upon this additional, court-created requirement, artful drafters will have little difficulty writing agreements (particularly tangential or subsequent, apparently wholly-unrelated side agreements) that appear not to be causally related to the termination of the interference. Rationalizing that such agreements are therefore not "causally related" to the interference termination, they will no doubt conclude that such agreements need not be filed in the Patent Office. Thus, few if any agreements will be filed in the Patent Office for Justice Department inspection.

More specifically, the court of appeals' addition of the "causal relationship" requirement to the statute appears to be an attempt to infuse the statute with equitable considerations. The statute is strictly punitive, however, and it leaves no room for equitable considerations (*United States v. FMC*, 215 U.S.P.Q. 43, 51, n.6-7 (E.D. Pa. 1982); *Moog v. Pegasus*, 521 F.2d 501, 502 (6th Cir. 1975); *Esso Research v. Brenner, Commissioner of Patents*, 425 F.2d 270 (D.C. Cir. 1970)), except for the six-month "grace period" which permits late filing upon a proper showing (not at issue herein because the agreements were never filed in the Patent Office).[2] A literal interpretation of the

[2] This "grace period" was incorporated into the statute in response to those who expressed concern about its harshness. Congress thus clearly set the limit as to any equitable consideration regarding enforcement of the statute.

broad all-encompassing terms of the statute is clearly what was intended by Congress (see pp. 6-7 herein).

Indeed, if the statute is not strictly applied, its sole purpose will be thwarted and, thereby, the statute effectively repealed because anything less than a literal application of the broad terms of the statute creates an easy means for evading the statute. There can be no doubt that parties bent upon entering into anticompetitive agreements in connection with interference settlements will seize upon this court-created means of evading the statute so that they may keep such agreements secret. As the court said in the *FMC* decision, *supra*:

> "A broad interpretation of the statute makes it difficult for parties to an interference to hide anticompetitive terms of their settlements in side agreements which do not 'causally' terminate the interference because even side agreements would have to be filed. A narrow interpretation, however, encourages parties seeking to circumvent the antitrust laws to hide provisions, offensive to the antitrust laws, in unfiled agreements which are tangentially related to the filed agreement." (*United States v. FMC*, 215 U.S.P.Q. 51, reversed on other grounds).

Moreover, not only does the "causal relationship" requirement added to the statute by the appellate court severely narrow the scope of the statute, but the appellate court's application of its self-created limitation of the statute reduces the scope of the statute to next to nothing. In other words, if a settlement agreement that *expressly* refers to an interference as a pending matter that the parties to the agreement are settling, as at least two did in the present case, does not have sufficient "causal relationship" to come within the scope of the statute, as the appellate court concluded, then it is very difficult if not impossible to conceive an agreement that would fall

within the appellate court's interpretation of the statute. Unless this Court grants this Petition, parties to an interference will have no trouble whatsoever drafting settlement agreements, with anticompetitive aspects, that fall outside the narrow "causal relationship" scope of the statute created by the appellate court's decision. Thus, these agreements will escape scrutiny by the Justice Department and their illegal aspects will remain secret.

Because all litigation involving Section 135(c) of Title 35 will be heard *only* by the Court of Appeals for the Federal Circuit, pursuant to 28 U.S.C. Section 1295(a), the statute effectively has been repealed unless the decision of that court is reversed.

B.

THE COURT OF APPEALS CONSTRUED THE STATUTE IN A MANNER CONTRARY TO THE CLEAR LANGUAGE OF THE STATUTE.

The terms used in the statute are broad, not narrow. The statute uses the terms "any", "understanding", "collateral", "in connection with", "or in contemplation of", all of which terms are obviously broad and intended to require the filing of as many agreements as possible, as very clearly evidenced by the statute's legislative history (e.g., see pp. 6 and 7 herein). Nowhere in the statute, nor in its legislative history, is there even the slightest hint that only a particular type and kind of patent interference settlement agreement need be filed.

Moreover, the court of appeals' decision does not address the important phrase in the statute "or collateral agreements referred to therein". By the use of this phrase alone, the statute itself emphasizes that agreements need *not* be "causally related" to the termination of the interference to fall within the scope of the statute.

Congress deliberately required the filing of *all* agreements, or understandings, bearing on the settlement of interferences to ensure that anticompetitive terms were not submerged in unfiled side agreements, *and enacted this statute which is specifically designed to accomplish that goal.*

C.

THE COURT OF APPEALS' CONSTRUCTION OF THE STATUTE IS CONTRARY TO THIS COURT'S GUIDELINES.

As this Court said in *Consumer Products Safety Commission v. GTE Sylvania*, 447 U.S. 102, 108 (1980):

> "[T]he starting point for interpreting a statute is the language of the statute itself. Absent a clearly expressed legislative intention to the *contrary*, that language *must* ordinarily be regarded as *conclusive*." (emphasis added).

In the present case, however, the appellate court did not apply the broad interpretation of the statute intended by both the literal meaning of the broad terms of the statute and by its legislative history. Rather, the appellate court added the nebulous requirement of "causal relationship" (727 F.2d 1550, 1556; Appendix p. B-11) which, particularly as applied by the appellate court, narrows the statute to the point where few, if any, settlement agreements (much less, "understandings" or "collateral agreements", to use the actual terms of the statute) need be filed. Consequently, if this interpretation of the statute is permitted to stand, the United States Department of Justice will rarely, if ever, be able to perform its duty to the public.

In *Commissioner v. Brown*, 380 U.S. 563, at 571 (1965) this Court said:

> "Unquestionably the courts, in interpreting a statute, have some 'scope for adopting a restricted rather than a literal or usual meaning of the words where acceptance of that meaning would lead to absurd results . . . or would thwart the obvious purpose of the statute.' (citations omitted). But it is *otherwise* 'where no such consequences would follow and where . . . it appears to be *consonant with the purposes of the Act. . . .*' " (emphasis added).

The appellate court in the present case, however, did not construe the statute in a manner consonant with its purpose of subjecting to review as many agreements as possible. Instead, the appellate court construed the statute in a manner such that very few, if any, agreements will be filed, which construction clearly thwarts the obvious purpose of the statute.

D.

THE COURT OF APPEALS' CONSTRUCTION OF THE STATUTE IS CONTRARY TO PRIOR CASE LAW.

The Sixth Circuit Court of Appeals in its decision in *Moog v. Pegasus*, 521 F.2d 501 (1975), points out the very strong public policy behind Section 135(c); that it is for the benefit of the public, not the parties (521 F.2d at 504). In *Moog*, the appeals court affirmed the district court's decision declaring a patent permanently unenforceable because of the failure to file a *supplemental* settlement agreement between the parties to the interference. The original settlement agreement was properly filed in accordance with Section 135(c) but, even though an agreement supplementing the original agreement was in fact filed with the Patent Office, it was not filed within the time prescribed by Section 135(c). In declaring the patent involved permanently unenforceable, the Sixth Circuit Court of Appeals held:

> "We hold that this statute [35 U.S.C. Section 135(c)] is designed to restrict monopolistic practice and (at least for purposes of this case) means just what it says and *requires no interpretation*" (521 F.2d 502; emphasis added).

In finding a violation of Section 135(c), the Court of Appeals for the District of Columbia said in *Esso Research v. Brenner, Comr. Pats.*, 165 U.S.P.Q. 486 (1970):

> "Although the sanction is concededly harsh, especially in a case like this where only human failure—and not deliberate disregard—was apparently involved, only Congress can conceivably relieve appellant from the consequences which *surely attach under the statute* as written." (emphasis added).

As previously noted at page 11, Congress responded to those who were concerned by the harsh penalty for violating the statute by providing a six-month "grace period." That was the limit to which Congress was persuaded to go as far as providing any equitable consideration in the statute.

CONCLUSION

Wherefore, Petitioners respectfully submit that the appellate court's decision herein, if allowed to stand, effectively repeals 35 U.S.C. Section 135(c). This statute was enacted by Congress for the purpose of protecting the public's "paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope, as set forth by this Court in the *Precision Instrument* decision.

The appellate court construed the statute in a manner contrary to the clear language of the statute, contrary to the expressed legislative intent, and in a manner that clearly conflicts with this Court's decisions regarding statutory construction and interpretation. By adding the "causal connection" requirement to the statute, which requirement is completely at odds with the terms and purpose of the statute, the appellate court so severely narrowed the scope of the statute that the Justice Department will rarely, if ever, be able to perform its duty to the public under the statute.

The appellate court's decision should be reversed, with instructions to the effect that the statute means exactly what it says and should be applied and enforced as written.

Respectfully submitted,

RAIFORD A. BLACKSTONE, JR.*
RICHARD R. TREXLER
TREXLER, BUSHNELL & WOLTERS, LTD.
141 West Jackson Boulevard
Chicago, Illinois 60604
(312) 427-8082
Attorneys for Petitioners

* Counsel of Record

APPENDIX A

Section 135(c) of Title 35 U.S.C. reads as follows:

"Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file in the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act. (Amended October 15, 1962, Public Law 87-831. 76 Stat. 958; and January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949)."

APPENDIX B

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CTS CORPORATION, *Appellee*,	)	Consolidated Appeal Nos. 83-1119 83-1120 83-1146 83-1147
v.	)	
PIHER INTERNATIONAL CORPORATION and PIHER SOCIEDAD ANONIMA, *Appellants.*	)	

DECIDED: February 17, 1984

Before KASHIWA and SMITH, *Circuit Judges*, and WISDOM,* *Senior Circuit Judge.*

KASHIWA, *Circuit Judge.*

This is a consolidated appeal from a judgment order of the United States District Court for the Northern District of Illinois (Nos. 72 C 1891 and 76 C 1152), entered May 25, 1983. In its oral findings of fact and conclusions of law, the district court denied, *inter alia*, Piher International Corporation and Piher Sociedad Anonima's

* The Honorable John Minor Wisdom, Senior Circuit Judge, United States Court of Appeals for the Fifth Circuit, sitting by designation.

("Piher") Rule 60(b)(6)[1] motion to modify the district court's judgment order entered January 25, 1982. *CTS Corp. v. Piher International Corp.*, 219 USPQ 1180. The Rule 60(b)(6) motion was sought in order to render unenforceable the agreements and the CTS patents which were cited in the January 25, 1982 judgment order because of appellee's, CTS Corporation ("CTS"), failure to file certain documents with the United States Patent and Trademark Office (the "PTO") pursuant to 35 U.S.C. § 135(c).[2] In addition, the district court denied appellee's motion for attorneys' fees. We affirm.

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[1] Rule 60(b)(6), F.R.Civ.P. 60(b)(6), states:

Rule 60. *Relief from Judgment Order*

(b) Mistakes; Inadvertence; Excusable Neglect; Newly Discovered Evidence; Fraud, etc.
On motion and upon such terms as are just, the court may relieve a party or his legal representatives from a final judgment, order, or proceeding for the following reasons:

* * * * *

(6) any other reason justifying relief from the operation of the judgment. The motion shall be made within a reasonable time * * *. A motion under this subdivision (b) does not affect the finality of a judgment or suspend its operation. This rule does not limit the power of a court to entertain an independent action to relieve a party from a judgment, order, or proceeding, or to grant relief to a defendant not actually personally notified as provided in Title 28, U.S.C., § 1655, or to set aside a judgment for fraud upon the court. Writs of coram nobis, coram vobis, audita querela, and bills of review and bills in the nature of a bill of review, are abolished, and the procedure for obtaining any relief from a judgment shall be by motion as prescribed in these rules or by an independent action.

[2] 35 U.S.C. § 135(c) states:

§ 135. *Interferences*

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before

(Footnote continued on following page)

Background

This case is the latest in a series of decisions dating back to 1975; the instant action is an appeal of the denial of a post-judgment motion relating to a patent infringement lawsuit.[3] During the relevant period of this appeal,

[2] *continued*

the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

[3] The infringement lawsuit comprised two civil actions the first of which, Civil Action No. 72 C 1891, involved Piher's infringement of four CTS patents. The four CTS patents are U.S. Patent Nos. 2,740,027; 3,375,478; 3,518,604; and 3,670,285 (the " '285" or "English" patent). In *CTS Corp. v. Piher Int'l Corp.*, 184 USPQ 399 (1975), the U.S. District Court for the Northern District of Illinois (the "Illinois court") found all four CTS patents, except for the '285 patent, valid and infringed. The Seventh Circuit Court of Appeals, in *CTS Corp. v. Piher Int'l Corp.*, 527 F.2d 95, 188 USPQ 419 (1975), *cert. denied*, 424 U.S. 978 (1976), affirmed the

(Footnote continued on following page)

late 1981 and early 1982, the infringement action was in its accounting phase in the U.S. District Court for the Northern District of Illinois (the "Illinois court"). Concurrently, a related interference civil action[4] was proceeding through the U.S. District Court for the Northern

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[3] *continued*
district court's decision except for the "on sale" defense as to the '285 patent. During remand, the "on sale" issue was retried and, in an unpublished decision dated March 17, 1978, the "on sale" issue was found in favor of Piher. This judgment, however, was reversed by the Seventh Circuit. *CTS Corp. v. Piher Int'l Corp.*, 593 F.2d 777, 201 USPQ 649, *cert. denied*, 444 U.S. 884 (1979).

The second infringement action, Civil Action No. 76 C 1152, related to Piher's alleged infringement of the '285 patent claims. Pursuant to a stipulation, this case was stayed pending the outcome of both the earlier infringement case and the interference, *infra*, note 5. The stipulation further provided that if CTS prevailed in both the first infringement action and the interference, a judgment of validity and infringement on the '285 patent would be entered. After the writ of certiorari for the first infringement case was denied in 1979, the Illinois court ordered that the accounting on all four CTS patents should proceed. Pursuant to the stipulation, a judgment order in favor of CTS was entered in the second infringement action on November 10, 1981.

[4] The statute relating to interference civil action, 35 U.S.C. § 146 (1976), states in pertinent part:

> § 146. *Civil action in case of interference*
>
> Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

District of Indiana (the "Indiana court") and the Seventh Circuit Court of Appeals.[5] The Indiana court's decision granting priority of invention to CTS was affirmed by the Seventh Circuit on November 4, 1981. *Piher S.A. v. CTS Corp.*, 644 F.2d 122, 212 USPQ 914.

On November 5, 1981, CTS contacted Piher concerning possible settlement. The Seventh Circuit issued its mandate for the interference case on November 6. On November 18, Piher filed a petition for rehearing at the Seventh Circuit regarding the interference case, and the Seventh Circuit withdrew its mandate shortly thereafter. On November 21, the PTO terminated its interference proceeding after receipt of the Seventh Circuit's affirmance of November 4 and the mandate of November 6. The PTO was not aware and the parties did not inform it that the November 6 mandate had subsequently been withdrawn.

In the afternoon of November 23, management representatives of CTS and Piher met to discuss and settle the accounting phase of the infringement case. It was a meeting between businessmen to negotiate a settlement. Legal matters were not discussed at this meeting. At the close of the meeting, CTS proposed a number of basic terms which could be used to form the basis of an agreement and gave Piher 24 hours to accept or reject them.

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[5] In 1973 Piher filed an application for reissue of its Heredero patent, U.S. Patent No. 3,662,314, in which it copies claims from CTS' '285 patent. the PTO, in *English v. Heredero*, 200 USPQ 597 (Bd. Pat. Intfr. 1978), awarded priority of all the counts to English, the CTS inventor. That decision, except for the suppression and concealment issue, was based on collateral estoppel because of findings relating to reduction to practice by CTS that had been made in the first infringement action. *Supra*, note 3. The Indiana court, however, in an unpublished opinion dated September 27, 1979, reversed the PTO. It rejected the collateral estoppel holding and remanded to the PTO for another determination. The PTO, in an unpublished decision dated April 18, 1980, again awarded priority to English. And, the Indiana court affirmed this decision. *Piher S.A. v. CTS Corp.*, 210 USPQ 806 (1981).

The next day, November 24, Piher accepted the basic terms presented by CTS. On November 25, CTS forwarded to Piher a draft of the proposed agreement. After exchanging several drafts, a copy of the agreement, entitled "Agreement in Principle" ("Document A"), was signed by CTS on December 10 and by Piher on December 16.

On December 2, the petition for rehearing of the interference was denied by the Seventh Circuit. The Seventh Circuit issued its mandate on December 10. Piher did not move to stay the issuance of the mandate for possible petition to the Supreme Court.

"Settlement Agreement" ("Document B") and "License Agreement" ("Document C"), the two remaining settlement documents, were executed by the parties on January 14, 1982. Both Documents A and B made references to the interference. For example, Document A, in relevant part, states:

> I. *FULL SETTLEMENT*
>
> CTS and PIHER shall join in an understanding for a release of PIHER and CTS of any claim or claims arising under the subject matter of paragraph III which either party has or could have asserted against the other, before a United States District Court, including but not limited to The United States Patent and Trademark Office, The United States District Court for the Northern District of Indiana, and The United States District Court for the Northern District of Illinois, Eastern Division, or any State Court of the United States or any Federal or Provincial Court of Canada.

Similarly, Document B, in relevant part, states:

> WHEREAS, PIHER and CTS have been adverse parties in each of the following proceedings:
>
> A. *CTS Corporation v. Piher International Corporation and Piher Sociedad Anonima*, Civil Action No. 72 C 1891, pending in the United States District Court for the Northern District of Illinois, Eastern Division, and Appeal Nos. 75-1100,

75-1104, 78-1535, 81-1635 and 81-1829 in the United States Court of Appeals for the Seventh Circuit taken therefrom;

B. *CTS Corporation v. Piher International Corporation and Piher Sociedad Anonima*, Civil Action No. 76 C 1152, pending in the United States District Court for the Northern District of Illinois, Eastern Division;

C. *Piher Sociedad Anonima (assignee of Juan Luis Heredero) v. CTS Corporation (assignee of Jack A. English)*, Civil Action Nos. S78-0174 and S80-1026, pending in the United States District Court for the Northern District of Indiana, South Bend Division, and Appeal Nos. 79-2350 and 81-1672 in the United States Court of Appeals for the Seventh Circuit; and

D. *English v. Heredero*, Interference proceeding No. 98-455 in the United States Patent and Trademark Office.

* * * * *

NOW, THEREFORE, in consideration of the mutual promises set forth herein, the parties agree as follows:

* * * * *

2. *Termination of Disputes.*

The parties hereto agree to terminate each of the above-identified civil actions and administrative proceedings between the parties by executing and causing to be filed the following documents:

In the United States District Court for the Northern District of Illinois, Eastern Division, in lieu of accounting procedures, there shall be a consent judgment entered by motion * * * and stipulation * * *, such judgment providing for termination and final settlement of all such civil actions and the consent

> judgment and final order * * * of the Court shall incorporate this Settlement Agreement, the Agreement in Principle, * * * and the patent License Agreement * * *, by which Piher shall hereafter be entitled to use, sell, distribute, and import into the United States and Canada products within the terms of the subject matter of Paragraph 6 hereafter.

On January 25, 1982, a stipulated consent judgment in lieu of accounting was entered by the Illinois court. Documents A, B and C were filed in that court under seal. On February 5, 1982, a copy of the January 25 consent judgment was filed in the PTO, but the three documents were not filed. In January, 1983, Piher filed the Rule 60(b)(6) motion in the Illinois court to modify the January 25, 1982 consent judgment because of CTS' failure to file Documents A, B and C with the PTO.

District Court Proceeding

The district court, in its oral findings of fact and conclusions of law, held that Piher failed to meet its burden of proving by the greater weight of the evidence that the parties had entered into an understanding or agreement which was required to be filed and was not filed with the PTO prior to the termination of the interference. Thus, the district court denied Piher's Rule 60(b)(6) motion to modify the final judgment order of January 25, 1982.

In its pre-trial memorandum opinion dated April 15, 1983, the district court interpreted section 135(c) to require, *inter alia*, that there must be a causal relationship between agreements or understandings and the termination of the interference. *CTS Corp. v. Piher International Corp.*, 219 USPQ 1177.

In determining the facts of this case, the district court, after hearing conflicting testimony, found that the evidence did not demonstrate a causal relationship between the settlement and the termination of the interference. It found that the possibility of filing a petition for certiorari to the Supreme Court was not discussed by the

participants at the November 23, 1981 conference. Next, the district court found that there was no bilateral understanding between the parties that the termination of the interference was part of the consideration for the settlement. Since the negotiations between the parties were not causally related to the termination of the interference, the district court found that the agreements need not be filed.

In addition, the district court denied CTS' motion for attorneys' fees since Piher's motion was not frivolous.

OPINION

The standard of review of a district court's denial of a Rule 60(b) motion is abuse of discretion. *See Darlington v. Studebaker-Packard Corp.*, 261 F.2d 903, 905 (7th Cir.), *cert. denied*, 359 U.S. 992 (1959); *see generally Bell Telephone Laboratories, Inc. v. Hughes Aircraft Co.*, 73 F.R.D. 16 (D. Del. 1976). Unless exceptional or extraordinary circumstances are shown, a Rule 60(b)(6) motion is generally not granted. *Ackermann v. United States*, 340 U.S. 193 (1950). The underlying factfindings by the district court in support of the denial must be upheld unless they are clearly erroneous. Fed. R. Civ. P. 52(a); *United States v. United States Gypsum Co.*, 333 U.S. 364 (1948).

Our jurisdiction is based on 28 U.S.C. 1295(a) (1982). *See Cinerama, Inc. v. Sweet Music, S.A.*, 482 F.2d 66, 71-72 (2d Cir. 1973) (a denial of a Rule 60(b)(6) motion is final and appealable).

I

35 U.S.C. § 135(c) was enacted to promote competition in the patent law area. As a means to prevent anticompetitive settlements between parties involved in patent interferences, any settlement agreements between parties must be filed with the PTO. Such agreements can therefore be reviewed by the Department of Justice's Antitrust Division by means of a "Civil Investigative Demand." *See Generally United States v. FMC Corp.*, 717

F.2d 775, 777-78, 219 USPQ 761, 763-64 (3rd Cir. 1983). The underlying motivation for the statute was clearly stated in the House Report. It stated:

> Recent experience has indicated that parties have sometimes used these interference proceedings in derogation of the public interest, in that interference settlement agreements have been entered into for the purpose of restricting competition. By requiring the filing of settlement agreements, the bill would make it more difficult for patent applicants and owners to use an interference settlement agreement as a means of secretly violating the antitrust law.

H.R. Rep. No. 1983, 87th Cong., 2d Sess. 1 (1962).

Section 135(c) requires that any agreement or understanding made in connection with or in contemplation of the termination of an interference must be filed with the PTO. *See Moog, Inc. v. Pegasus Laboratories, Inc.*, 376 F. Supp. 439, 444, 180 USPQ 4, 8 (E.D. Mich. 1973), *aff'd*, 521 F.2d 501, 187 USPQ 279 (6th Cir. 1975), *cert. denied*, 424 U.S. 968 (1976) ("[A]ll agreements, whether initial or supplemental, with actual or potential anti-trust implications, must be filed in accordance with Section 135(c) or suffer the penalty of unenforceability."). Failure to file with the PTO renders such agreement or understanding and any patent involved in, or subsequently issued on an application involved in, the interference unenforceable.

A

The appellants argue that the district court misinterpreted section 135(c) and that the settlement agreements are clearly within the scope of the statute.[6] Piher con-

[6] We note with interest that appellee contends that an "interference," as stated in section 135, refers only to the proceedings in the PTO and not to the proceedings in the district courts under section 146. Thus, the "interference" in the instant case terminated in 1980 when the PTO granted priority to CTS. We, however, do not and need not reach this issue. Moreover, the record for this issue was not fully developed below.

tends that the agreements were made in connection with or in contemplation of the termination and, as such, were the direct cause of the termination. Whereas the district court found there was no causal relationship between the agreements and the termination, the appellants contend otherwise. We disagree with the appellants.

We agree with the district court that, pursuant to section 135(c), there must be a causal relationship between the agreements and the termination of the interference. *See United States v. FMC Corp.*, 215 USPQ 43, 51-53 (E.D. Pa. 1982), *rev'd on other grounds*, 717 F.2d 775, 219 USPQ 761 (3rd Cir. 1983); *cf. Moog*, 521 F.2d at 506 ("The District Court was right in finding a causal relationship between the withholding [of an agreement] and the termination of the interference.").

First, the appellants disagree with the district court's finding that the possibility of filing a petition for writ of certiorari in the interference case was not discussed during the November 23, 1981, settlement meeting between the parties. Based on these alleged discussions of the certiorari petition, Piher argues that at least Document A was made in contemplation of the termination. We, however, disagree.

Evidence presented at trial points to the district court's conclusion that the question of filing a certiorari petition was not discussed at the afternoon meeting of November 23. The district court heard conflicting testimony on this point and found that legal questions such as the certiorari petition were probably not discussed since the afternoon conference was a meeting between businessmen. In light of the circumstances and the evidence presented, the district court found that Piher failed to meet its burden of proving that the certiorari petition was discussed at the afternoon meeting. The district court stated:

> It is not implausible that the subject [of certiorari] would have been mentioned. Piher had indeed filed certiorari petitions on two prior occasions, and it's not inconceivable that the lay representatives of the

company might have had such a possibility in mind on November 23.

What is missing is any testimony whatsoever, or evidence of any kind whatsoever, that anybody on the Piher side of the case thought that Piher had any chance whatsoever to succeed on a petition for certiorari.

It is not enough that the laymen simply testified that they discussed the question of certiorari. There has to be more, in my view. There has to be some indication that they actually thought this was a remedy which held out some hope of relief.

There is no such testimony.

219 USPQ at 1181.

We hold that the district court committed no clear error in finding that the possibility of filing a writ petition was not discussed at the November 23 meeting, and thus, no causal relationship was shown.

B

The appellants next dispute the district court's finding that forbearing from a petition for certiorari was not mutually regarded by the parties as part of the consideration for the settlement. In this regard, the appellants argue that references to the interference in the documents, especially Documents A and B, indicate a connection between the settlement of the infringement lawsuit and the termination of the interference. We again disagree.

The district court found that there was no evidence indicating such a connection since there was no bilateral understanding between the parties that the termination of the interference was part of the consideration for the settlement. In its analysis, the district court first examined the direct evidence, *i.e.*, the documents in evidence, and found that they did not demonstrate a causal relationship between the settlement of the infringe-

ment and the termination of the interference. The district court stated:

> It is commonplace for parties entering into written settlement agreements to include all possible grievances that might or could exist between them, without reference to whether they are still technically extant. It is very common in the boilerplate releases that are commonly used by lawyers to recite that the parties are mutually giving up all causes of action they might have, known and unknown, and which exist now or at any time since the beginning of the world.
>
> Now, those very words, "since the beginning of the world," are very common recitals in mutual releases.
>
> Obviously, parties are not concerned at the time they enter such agreements with anything that has happened since the beginning of the world. That I suppose, and to make it absolutely clear that the parties mean to have no further controversy after the execution of the agreement.
>
> But that doesn't mean that it is the agreement that is terminating all of those controversies that could have existed since the beginning of the world.
>
> And, by the same token, the fact that this settlement agreement in this case refers to the interference doesn't mean that it is that document that is terminating the interference as a matter of fact.

219 USPQ at 1182.

In addition, the district court found that the circumstantial evidence did not support Piher. First, the possibility of certiorari was unlikely since the Supreme Court grants only around 180 out of 4,000-5,000 certiorari petitions a year and rarely accepts a patent case. Next, if Piher's attorney had believed there was any respectable chance of a successful certiorari petition, he would have stated so to his client. The absence of any letter or testimony to this effect by anyone on the Piher side is strong cir-

cumstantial evidence that Piher believed that there was no practical possibility of a successful appeal to the Supreme Court. *See Evans, Inc. v. Tiffany & Co.*, 416 F. Supp. 224, 232 (N.D. Ill. 1976). Similarly, there was no evidence that CTS was worried about a certiorari petition and no documentary or testimonial evidence to indicate such concern. CTS and its lawyers acted as though the interference was over.

We hold that the district court committed no clear error in finding that references to the interference in Documents A and B did not indicate a causal relationship between the settlement of the infringement and the termination of the interference.

C

In accordance with its interpretation that only agreements which have a causal relationship with the termination need be filed with the PTO, the district court stated that Documents A, B and C need not be filed with the PTO since they were not made in connection with or in contemplation of the termination of the interference.[7] The district court's findings are not clearly erroneous.

II

In addition, the appellee argues that the district court abused its discretion in its denial of appellee's motion for attorneys' fees pursuant to 35 U.S.C. § 285. The district court concluded that although Piher's motion was meritless, it nonetheless was neither frivolous nor brought only for harassment or delay. We therefore, fail to see where

[7] Appellants also argue that the district court may have mistakenly interpreted the statute to require that only *anti-competitive* agreements need be filed, which is contrary to *FMC Corp.*, 215 USPQ at 50 note 3. Since resolving this issue will not alter the outcome of this case, we need not and do not reach it.

the district court abused its discretion. *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 219 USPQ 670 (Fed. Cir. 1983).

Conclusion

Since the district court's findings of fact are not clearly erroneous and it did not abuse its discretion in denying the various motions, we affirm the district court's decision.

AFFIRMED

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

CTS CORPORATION, *Plaintiff,*	)	
v.	)	No. 72 C 1891
PIHER INTERNATIONAL CORPORATION, et al., *Defendants.*	)	

MEMORANDUM DECISION

The defendant has filed a motion to modify the final judgment order entered in this case on January 25, 1982, alleging that the '285 patent is now invalid by reason of plaintiff's failure to file certain documents with the Patent Office prior to the termination of the interference proceeding or within six months thereafter.

As a preliminary matter, I agree with defendant that the motion presents a justiciable controversy. Defendant is seeking to avoid certain of its present obligations under the judgment order, such as the payment of $200,000.00 to plaintiff, and plaintiff insists upon enforcement of the order as entered. The court has retained jurisdiction to enforce the judgment, and it seems clear that a real, present controversy exists.

Turning now to the merits, the initial question seems to be one of statutory interpretation. 35 U.S.C. § 135(c) provides that

> Any agreement or understanding between parties to an interference . . . made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding.

The statute goes on to provide that failure to file the agreement shall render it and any subsequently issued patents unenforceable. The Commissioner of Patents may, however, "on a showing of good cause for failure to file within the time prescribed," permit the filing up to six months after the termination of the interference.

Plaintiff argues that this statute contemplates only agreements which have a causal relationship to the termination of the interference, and defendant does not contend otherwise. The phrase "made in connection with or in contemplation of" seems clearly to import a causal relationship between the agreement and the termination of the interference. I adopt this interpretation, which is consistent with the purpose and the legislative history of the statute.

The contested question of interpretation relates to the timing required by the statute. Plaintiff argues that because the statute requires that the agreements be filed ". . . before the termination of the interference, . . ." an agreement which is reduced to writing only *after* the termination of the interference need not be filed. Defendant, on the other hand, takes the position that all agreements which, in the words of the statute, are "made in connection with or in contemplation of the termination of the interference" must be filed, whether they were entered into before or after the termination. Defendant contends that pre-termination agreements should be filed before the termination and that agreements arrived at "shortly after" the termination should be filed "upon a proper showing, within six months thereafter." Def. Reply Brief p. 9. Pointing out that the purpose of § 135(c) is to pre-

vent anticompetitive conduct, defendant argues that "to adopt CTS' position would create and encourage an obvious way for parties bent upon entering into anticompetitive agreements to avoid the statute." *Id.* at 9-10.

Defendant's interpretation ignores the language "before the termination of the interference . . .," which clearly designates the deadline for the required filing.[1] Defendant is conscious of the fact that its argument accommodates only those post-termination agreements which might be entered into "shortly" after the termination—that is, within six months after termination. This interpretation of the statute would not materially deter parties "bent upon entering into anticompetitive agreements to avoid the statute." Such parties could simply let the six months go by and *then* commit their agreement to writing. Moreover, defendant's scenario of parties to an interference proceeding being so trustful of each other that they would be willing to wait until after the interference is terminated before setting down in writing the terms of their agreement does not seem realistic to me.[2] Finally, and most importantly, I am at a loss to understand how the plain language of the statute can be construed to permit, let alone to *require*, the filing of an agreement entered into after termination of the interference.

> The Commissioner may, however, on a showing of good cause for failure to file within time prescribed, permit the filing of the agreement or understanding during the six month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

This provision refers to the filing of agreements entered into during "the time prescribed" and allows a *late* filing of such agreements only upon a showing of good cause. All this portion of the statute *requires* is an exercise of discretion by the Commissioner; it neither requires nor permits the filing of an agreement entered into after termination of the interference.[3]

I conclude that § 135(c) requires the filing of agreements which have been reduced to writing prior to the termination of the interference, and no others.[4]

I turn now to a discussion of the agreements in this case.

The parties recognize that the earliest written memorandum of an agreement or understanding in this case was prepared on December 11, 1981, and was not fully executed by all parties until December 16, 1981. This was the "Agreement in Principle" which incorporated the preliminary understanding reached by the parties at a conference held on November 23, 1981. The other two written agreements, a mutual release and a license agreement, were executed on January 14, 1982, eleven days prior to entry of the agreed final judgment.

The earliest any agreement would have had to be filed with the Patent Office in this case, then, was December 16, 1981, the date the "Agreement in Principle" was fully executed. If the interference had not already been terminated, the agreement should have been filed. The crucial question in the case, then, is when the interference was terminated. This requires a brief chronology.

On November 4, 1981, the Seventh Circuit Court of Appeals affirmed the district court judgment in favor of plaintiff on the merits of the interference proceeding. *Piher v. CTS Corp.*, 664 F.2d 122 (7th Cir. 1981). (Judge Allen Sharp of the Northern District of Indiana had affirmed the decision of the Board of Patent Interferences awarding the patent to plaintiff). On November 6, 1981, the Court of Appeals issued its mandate, but because it was issued before the time for filing a petition for rehearing had expired, that mandate was recalled. Defendant did file a timely petition for rehearing, which was denied on December 2. On December 10, the Court of Appeals issued a new mandate. All three of the pertinent actions of the Court of Appeals—its decision of November 4, its order of December 2 denying rehearing, and its issuance of a mandate on December 10—occurred before the first

written agreement between the parties concerning the interference was prepared and signed by plaintiff on December 11 and signed by defendant on December 16. If any of these actions of the Court of Appeals "terminated" the interference for purposes of § 135(c), there was no requirement that the agreement be filed with the Patent Office.

Defendant argues that because its time to file a petition for a writ of certiorari did not expire until March 2, 1982, the interference could not be regarded as terminated by court action until that date had passed without a petition being filed. If this is true, then the parties were required to file not only the December 11 agreement but the two agreements of January 14, 1982, as well.

It is here that the requirement of a causal relationship between the agreement and the termination of the interference becomes important. The "Agreement in Principle" prepared on December 11, 1981, and the settlement agreement dated January 14, 1982, both refer to the interference as one of the proceedings the parties were agreeing to terminate. Defendant argues that the interference was still considered viable by the parties at the time of these agreements and that defendant's forgoing a petition for certiorari was part of the consideration for the settlement. The Heredero Affidavit is submitted to support that argument, but it does not really do so. Paragraph 4 of the affidavit simply states that one of the remedies defendant still had available was "the possibility of filing a petition for writ of certiorari." The affidavit does not say that this possibility was discussed between the parties. Plaintiff, in its brief, denies that there was any such discussion or that the interference played any role in the settlement.

If, as a matter of law, the interference is to be considered pending, and therefore not "terminated" within the meaning of § 135(c), until the time for filing a petition for certiorari has expired, then it would follow that a settlement agreement between the parties predicated, even in part, upon an agreement not to petition for cer-

tiorari would be an agreement "made in connection with or in contemplation of the termination of the interference . . ." within the meaning of § 135(c). On the other hand, if the interference had already terminated as a matter of law by reason of the Court of Appeals decision of November 4, or the order of December 10 denying the petition for rehearing,[5] then the agreements of December 16 and January 14 need not have been filed, even if the parties did have the possibility of certiorari in mind when the agreements were executed.

It is not clear to me that defendant is actually contending and is prepared to prove that consideration of a possible certiorari petition did enter into the settlement discussions between the parties. If no such contention is being made, then it is not necessary to resolve the legal question of whether the possibility of a certiorari petition keeps the interference alive for purposes of § 135(c). If the contention is being made, then we should have an evidentiary hearing to determine what the fact is. This is not something that can be resolved by affidavits.[6] If defendant prevails on the factual question, I will then decide whether the interference had been terminated prior to execution of any of the written agreements.

The case is set for a conference on April 20, 1983, at 3:00 p.m. to set an early date for an evidentiary hearing if one is required.

Dated: 15 APR 1983

ENTER: /s/ John F. Grady
United States District Judge

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[1] That the phrase was so understood by the sponsors of the legislation is indicated by one of the exhibits to defendant's reply brief, a letter dated April 30, 1962, to the Chairman of the House Judiciary Committee from Nicholas D.B. Katzenbach, Acting Deputy Attorney General, describing the legislation (and the amendment the Department of Justice was proposing, which was adopted) as providing that the agreement must be filed "*prior to*

the termination of the interference." (Emphasis added). The pending bill and the subsequently adopted legislation did not use the words "prior to." They used the word "before." The Katzenbach letter indicates that the word "before" was intended to have its usual meaning.

[2] The instant case is perhaps an extreme example of mutual distrust, involving, as it does, years of accusations and counter-accusations of obduracy, misrepresentation and concealment, but my exposure to patent cases over time has erased my early impression that the patent bar works together more harmoniously than other branches of the profession.

[3] The sense of the provision was explained by Mr. Katzenbach, n. 1 *supra*, in his letter to the Chairman of the House Judiciary Committee:

> In order to protect innocent parties *who inadvertently fail to file a copy of their settlement agreement*, the Commissioner of Patents should be given the authority to entertain, at any time during the 6-month period subsequent to the termination of the interference, a petition by either party for leave to file a copy of the agreement, which petition may be granted on a showing of good cause *for the failure to file within the time prescribed.*

(Emphasis added).

[4] This interpretation does leave open the possibility that parties might intentionally wait until after termination of the interference to reduce their prior agreement to writing. I believe the risk of this is slight, for the reason indicated at note 2, *supra*. The statute probably covers the bases as well as can be done. But in any event, any loophole in the statute is a problem for Congress. My function is to apply the statute, not to rewrite it.

[5] I do not consider Paper No. 206 of the Patent Office, issued November 21, 1981, to be the significant action on the question of termination. Although this document did state that ". . . this interference is considered to be terminated as of the date of the court action . . .," the court action referred to was the Court of Appeals decision of November 4 and the mandate issued on November 6. Since that mandate has been withdrawn, the premise of Paper No. 206 was mistaken.

[6] Plaintiff's motion to strike the Heredero Affidavit is denied as moot. I have considered the affidavit but do not find it probative.

APPENDIX D

[1]* IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

CTS CORPORATION, a corporation,	)	
Plaintiff,	)	
v.	)	No. 72 C 1891 and 76 C 1152
PIHER INTERNATIONAL CORPORATION, a corporation, et al.,	)	
Defendants.	)	

EXCERPT OF PROCEEDINGS

had at the hearing of the above-entitled cause before The Honorable JOHN F. GRADY, one of the Judges of said Court, in his courtroom in the United States Courthouse, Chicago, Illinois, on Monday, May 23, 1983, at the hour of 10:00 a.m.

PRESENT:

MASON, KOLEHMAINEN, RATHBURN & WYSS
(20 North Wacker Drive, Suite 4200
Chicago, Illinois 60606) by
MR. WALTHER E. WYSS and
MR. JOSEPH KRIEGER

on behalf of the plaintiff;

* Numbers in brackets refer to the official court reporter's original pagination of the Excerpt of Proceedings.

TREXLER, BUSHNELL & WOLTERS, LTD.
(141 West Jackson Boulevard, Suite 3440
Chicago, Illinois 60604) by
MR. RAIFORD A. BLACKSTONE, JR. and
MR. RICHARD R. TREXLER

on behalf of the defendant.

* * * * *

[2] THE COURT: I will give you my findings of fact and conclusions of law.

The parties appear to agree that the defendant has the burden of proof in its motion to modify the final judgment order of January 25, 1982.

The defendant has the burden of proving by the greater weight of the evidence that the parties entered into an understanding or agreement which was required to be filed prior to the termination of the interference, and that such agreement or understanding was not filed prior to the termination of the interference.

The first question I address is whether the possibility of a petition for certiorari or a petition for rehearing in the Seventh Circuit was discussed by the participants in the conference which took place on November 23, 1981.

The testimony is in conflict. While Mr. Salvador stated in his rebuttal testimony that the matter of certiorari was not discussed, and that the term certiorari was not used, I do not interpret that testimony to mean that he was saying the subject of pursuing the case to the Supreme Court was not mentioned.

It is the sense of his testimony, as I understand it, that the Supreme Court was mentioned, even though the precise term certiorari was not mentioned.

[3] Mr. Molins, on the other hand, testified, according to my notes, that a petition for certiorari was mentioned at the meeting. He did not modify his testimony or in any way indicate that it was merely the subject of going to the Supreme Court that was mentioned, but instead

stated in his testimony, which has not been retracted, that a petition for certiorari was discussed.

So there is a conflict between the rebuttal testimony of Mr. Salvador and the testimony of Mr. Molins.

And, of course, there is testimony between the Piher witnesses and the CTS witnesses on the question of whether certiorari or a petition for rehearing was mentioned.

It is not implausible that the subject would have been mentioned. Piher had indeed filed certiorari petitions on two prior occasions, and it's not inconceivable that the lay representatives of the company might have had such a possibility in mind on November 23.

What is missing is any testimony whatsoever, or evidence of any kind whatsoever, that anybody on the Piher side of the case thought that Piher had any chance whatsoever to succeed on a petition for certiorari.

It is not enough that the laymen simply testified that they discussed the question of [4] certiorari. There has to be more, in my view. There has to be some indication that they actually thought this was a remedy which held out some hope of relief.

There is no such testimony.

Another factor which is of significance is that this meeting was expressly agreed by both sides to be one at which laymen would negotiate for the parties. As one of Piher's witnesses stated, this was to be a meeting between businessmen.

Clearly what was intended as the subject of discussion was the economics of a possible settlement, not legal questions. Had it been intended to discuss legal questions, lawyers would have been present in their capacity as lawyers. That is precisely what the parties did not intend would occur.

As far as the appearance and the demeanor of the witnesses on both sides of the case, neither side has an ad-

vantage. I'm not going to pretend to be a mind-reader and to know on the basis of the demeanor of the witnesses which of them is lying.

Clearly somebody is lying, and quite clearly one of two lawyers admitted to the Bar is lying.

That is a truly tragic aspect of this case. And I frankly hope that it will cause the culprit considerable unrest during the remainder of his days in [5] the practice of the profession he has sullied by his conduct in this case.

I don't know whether it is Mr. Molins or Mr. Taylor who is lying, but one of them is. And the guilty one should feel ashamed and should carry that shame to his grave.

Considering all of the circumstances and all of the testimony and documentary evidence on the point, I am not satisfied by the greater weight of the evidence that the subject of certiorari or going to the Supreme Court or filing a petition for rehearing was discussed at the meeting between the Piher and the CTS representatives on the afternoon of November 23.

Piher has the burden of proof and has failed to carry that burden. The most I can say is that the evidence is a standoff.

That, however, does not end the inquiry. In fact, the question of whether those matters were discussed turns out to be one that is not of critical importance, in my view.

The question which is of critical importance is whether the possibility of rehearing and certiorari was mutually regarded by the parties as part of the consideration for the settlement.

It doesn't make any difference that the [6] question of certiorari or rehearing may have been in the minds of plaintiff's representatives, if that possibility played no part in bringing this case to a conclusion and in terminating the interference.

What we need to look for is evidence that Piher thought it was giving up something by way of dropping the interference in consideration for this settlement and, in addition, evidence that CTS believed it was receiving something in the form of terminating the interference as a result of this settlement.

In short, what there has to be is a bilateral understanding that the termination of the interference is part of the consideration for the settlement.

There are two kinds of evidence to be considered on that question. There is direct evidence and there is circumstantial evidence. I'll deal first with the direct evidence.

The documents executed by the parties refer to the interference proceeding and mention that the interference proceeding is one of the items being settled.

That recitation is, of course, evidence in favor of the proposition that those words mean what they say, namely that the interference is being settled.

[7] The other direct evidence is the testimony of the Piher witnesses that a possible petition for certiorari was discussed in the meeting of November 23.

I've already indicated that that testimony has not persuaded me that the subject was in fact discussed.

But, going further, even if I were persuaded that the precise conversation testified to by the Piher witnesses had in fact taken place, that evidence would tend to show that there was only one party at most who might have thought that there was any possibility of certiorari being granted.

The conversation was a very short one, if it occurred, and the only thing that the CTS representative said was something to the effect: "Have you asked your lawyer what your chances are?"

Now, if Mr. Taylor made that statement, he was in effect saying: You have no chances or, your chances are so slim as to be unworthy of consideration in this conference.

Paradoxically, I find this conversation that CTS so strongly contends occurred--strike that--which Piher so strongly contends occurred actually tends more to support CTS' case, in that it demonstrates a contemporaneous contempt, if you will, for any certiorari petition that Piher might file.

[8] Certainly there is nothing in the testimony of the conversation that allegedly took place that indicates a mutual consciousness of the importance of the possibility of a certiorari petition. And it is a mutual consciousness and a mutual motivation that, in my view, is required by the statute.

Now, what is the effect of the recitals in the settlement documents standing alone: I find that they do not demonstrate a causal relationship between the settlement and the termination of the interference.

It is commonplace for parties entering into written settlement agreements to include all possible grievances that might or could exist between them, without reference to whether they are still technically extant. It is very common in the boilerplate releases that are commonly used by lawyers to recite that the parties are mutually giving up all causes of action they might have, known and unknown, and which exist now or at any time since the beginning of the world.

Now, those very words, "since the beginning of the world," are very common recitals in mutual releases.

Obviously, parties are not concerned at the time they enter such agreements with anything that has happened since the beginning of the world. That language is put in there as an overabundance of caution, [9] I suppose, and to make it absolutely clear that the parties mean to have no further controversy after the execution of the agreement.

But that doesn't mean that it is the agreement that is terminating all of those controversies that could have existed since the beginning of the world.

And, by the same token, the fact that this settlement agreement in this case refers to the interference doesn't mean that it is that document that is terminating the interference as a matter of fact.

Now, what is the circumstantial evidence on the question of whether there was a mutual understanding that, by their settlement, the parties were terminating the interference:

The first thing I look at is the nature of the Seventh Circuit decision. It was a thorough decision; it was unanimous; it dealt with questions that were not novel or unduly difficult; it was concerned mostly with factual questions as to which there was a strong presumption in favor of the Patent Office determination.

In short, it was a decision which held out virtually no possibility of rehearing; and, to the extent that anything in the area of what the Supreme Court might do can be considered a practical certainty, there was a practical certainty that certiorari would not [10] be granted.

The petition for rehearing was denied without opinion, just as a matter of course. Not without reflection, I'm sure, but nonetheless as a matter of course, because the Court had exhausted, considered every point raised by Piher, and had dealt with every point fully.

Now, as to the possibility of certiorari, the United States Supreme Court this year granted 180 certiorari petitions. That is the largest number they have ever granted.

Many members of the Court have publicly gone on record to the effect that the Court is granting too many petitions, that the quality of the Court's work is suffering, and that the number of petitions granted must be cut back if the Court is going to be able to continue to function on a level which comports with its own expectations of the kind of work it should be doing.

I recently attended the Seventh Circuit judicial conference and heard Mr. Justice Stevens state very strongly

that he believes the Court improvidently grants too many petitions. Other Justices have made the same remarks. And, as you know, there is a very strong recommendation that has been made by the Chief Justice and other Justices that another Court be created to deal with the question of which certiorari petitions should be [11] granted.

Now, I mention all this because there are something like 5,000 certiorari petitions that are filed. And I could be wrong on that. There are statistics published by the Administrative Office which show what the actual facts are. But it seems to me that 4,000 or 4,500 or 5,000 is the correct figure. And out of those only 180 are granted, and the Court thinks that's too many, at least some members of the Court think that is too many.

Patent cases are rarely accepted for review by the Supreme Court. We all know that. It's very, very rare.

And, again, to the extent that one can speak with any degree of certainty in questions of what a Court will do, it is a practical certainty that the United States Supreme Court would not have accepted this case for review. There is just nothing about this case at this juncture that is the stuff of which Supreme Court decisions are made.

Now, as a second item of circumstantial evidence I point to something that is missing, and that is the least suggestion, the least fragment of any indication that Piher's counsel thought differently about any of the matters I have just been discussing.

I practiced law for many years; I know [12] that it is customary in the legal profession to advise your client fully about his prospects of successful further review when you have lost a case on any level of our Court system.

Indeed, lawyers who are jealous of their professional reputations usually are very careful to commit opinions of that kind to writing and to make sure that their clients fully understand what recommendation the attorney is making.

I think it is highly likely that if the attorneys for Piher had believed there was any respectable chance of a successful petition for certiorari in this case, there would be in their file a letter to their client so stating.

The absence of any such letter, the absence of any testimony to the effect that any such opinion was ever held by anybody on the Piher side of the case is, in my view, strong circumstantial evidence that Piher knew there was no practical possibility of a successful appeal to the Supreme Court.

The only lawyer who testified in this proceeding for Piher is a lawyer who admits that he knows nothing about the merits of this case and knows nothing about the patent law. And he is the witness who is supposed to persuade me that Piher was seriously [13] considering a certiorari petition. That effort, as I have indicated previously, was unsuccessful.

It was interesting to me to see the transcript this morning of the November 10, 1981 hearing on the injunction order. Mr. Blackstone made the comment, "Technically the injunction order would be premature."

Well, now, when a lawyer talks about something being technically premature, we know what he means: He means he isn't seriously advancing the proposition.

And in the context of that particular hearing, I have no doubt whatever that that is precisely the idea that Mr. Blackstone was intending to convey to me, and that that is precisely how he felt as he stood there on November 10th.

Some documentation of a contemporaneous belief in the viability of a certiorari petition would have been far more persuasive to me than simple reference to the fact that Piher had petitioned for certiorari on two previous occasions.

Now, for its part, there is absolutely no evidence that CTS was worried about a certiorari petition. Not a scrap of paper in their file or a syllable of testimony by anybody

in this proceeding shows any consciousness on the part of the attorneys for CTS that certiorari was something to worry about back in late 1981 and early [14] 1982.

CTS and its lawyers acted as though the interference was over with. You look at everything they did, in Court and out, and their actions are completely consistent with the proposition that they thought the interference was done with.

What was it that the parties were discussing at the November 23rd meeting, what was it that was being settled with these documents that were drawn up:

I find that it was the accounting phase of this case, which was regarded by CTS, and by Piher as well, as the subject of their proposed settlement.

The reference to fighting to the end could well have meant the accounting proceeding, if any reference to fighting to the end was made.

I recall very well the numerous appearances that the parties made before me on this question of accounting, which has dragged out for years.

It is clear to me that there could have been a lot more foot-dragging and a lot more discovery and a lot more controversy over that question of accounting. It may have been necessary to have an evidentiary hearing on the matter. And whatever order I might have entered ultimately on the question of accounting could have been appealed. And, of course, a petition for certiorari could [15] have been filed as the end item in that exercise.

In short, there is absolutely no difficulty in accounting for all of the behavior of the parties here on the basis that they were negotiating the end of what could have proved to be a long battle on the matter of accounting, and that they were negotiating that in the light of representations to the effect that Piher was in shaky financial condition.

Any concessions made by CTS, if there were any, are readily understandable in light of those two considerations.

Now I turn to the question of whether the negotiations of the parties which led to certain written agreements should have been filed with the Patent Office. I will leave aside for the moment the question of when the interference was terminated and when the filing should have taken place.

Looking at the purpose of the statute, which is to require the filing of agreements which might be anti-competitive in nature, it is clear that an agreement which is not causally related to the termination of the interference need not be filed. I have already held that in my written opinion concerning this proceeding.

If you look at what occurred here concerning the interference, it is impossible to conclude [16] that what the parties were doing had any antitrust significance. The interference was fully litigated before the Patent Office, before the District Court, before the Court of Appeals. As a practical matter, it was over.

There is no evidence that Piher had anything to sell at that point as far as the interference was concerned. And there is no evidence, no credible evidence, that CTS believed it was receiving anything in the settlement as far as the interference was concerned.

I find, therefore, that the agreements in this case were not made in connection with or in contemplation of the termination of the interference, in the words of the statute.

Moreover, the agreements which were made were made after the interference was already terminated.

This brings us to an analysis of the question of when the interference was terminated.

I believe the termination, in the words of this statute, or within the meaning of this statute, must be given a practical construction, consistent with the legislative purpose.

It may be that termination in the context of this statute, or even in the context of this particular case under the

statute may not be the same as termination in some other context or under some other statute.

[17] And termination under this statute may not mean the same thing as becoming final under some other statute or judicial construct.

I have concluded ultimately that, in that practical construction of the statute, this interference was terminated on November 4, 1981, when the Court of Appeals decided in favor of CTS.

That construction overlooks the possibility of rehearing and certiorari. I believe, in the context of this case—and I underscore the word "this"—in the context of this case, that is the proper interpretation.

I believe that in the context of another case where, for instance, you might have had a two-to-one panel decision by the Court of Appeals, where novel questions might be involved, where there might even be a conflict with a different panel of the circuit, or a conflict with another circuit, that a Judge applying the statute in such a context would have to take into consideration the viability of a petition for rehearing or a petition for certiorari.

In other words, what I'm saying is, this statute cannot be mechanically interpreted or applied. It uses what sensibly can only be interpreted as a term of art when it uses the term "termination."

In this case there was no realistic chance [17] of rehearing being granted or certiorari being granted.

The petition for rehearing was denied on December 2nd. The mandate did not issue until December 10. It might be argued that December 2nd should be the date of termination, or that December 10, the date of the mandate, the second mandate, should be the date of termination.

I reject both of those propositions for the reasons I have just indicated.

And I point out further that, as a practical matter, the issuance of the mandate after the denial of the petition

for rehearing was not a significant event. Certainly by December 2nd it was clear that the Court of Appeals was not going to do anything more with this case.

To say that the case was still alive as far as the Court of Appeals was concerned, and for purposes of Section 135(c), for another eight days until the mandate issued, seems to me to be a proposition with no visible merit.

One would have to assume that, during the period December 2 to December 10, there was some possibility that the Court of Appeals might change its mind, that it might, sua sponte, decide to grant rehearing.

Such a possibility is not merely remote, [19] it is nonexistent in the facts of this particular case.

So if I am wrong about November 4 being the date of termination, then my next date of termination would be December 2, the date that the petition for rehearing was denied. I do not regard December 10 as being a significant event for the reason I have indicated.

Now, on November 4 there had been no talk of settlement, or at least the only talk of settlement might have had to do with setting up a meeting, but I'm not even sure that had occurred by November 4. So if I am correct in saying that November 4 is the date of termination obviously no agreement need have been filed.

If December 2 is the date of termination, then we must grapple with the question of whether any of the agreements prior to those of December 16 and January 14 can be considered agreements that should have been filed.

I reject completely the argument of Piher that these parties had entered into what they each believed was a binding agreement on the 25th of November.

Piher's testimony that it regarded itself bound at that time is absurd, in view of the history of this litigation, up to the present moment.

Here we have a party which is renouncing a [20] series of signed agreements, agreements A, B, and C, signed,

sealed, and delivered; utterly turning its back on the supposed solemnity of those agreements on the basis of what has to be the most sterile technicality that either side has come up with during the long history of this case.

Each side knows that there is nothing anti-competitive about the agreement that was arrived at in this case. Each side knows that the purpose and spirit of Section 135(c) has nothing whatever to do with this case. And yet Piher, in order not simply to get out of an agreement it entered into in apparent good faith, but to invalidate the patents of CTS, is now renouncing its agreements.

Now, for a party who does that to tell me that it regarded itself bound on the basis of an oral understanding reached at a conference on November 23, or any one of the obviously preliminary and preparatory drafts exchanged between the parties thereafter between then and the execution of the final agreements, is imposing unduly upon my credulity.

I find as a fact that Piher would have turned its back on any of these agreements at any time had it seen fit to do so, and would have asserted as a reason for doing so the fact that they were not final.

[21] It is perfectly apparent from this evidence that both sides regarded the writings that were exchanged prior to the signing of the agreement in principle on December 16 as drafts of an agreement that would not be considered binding until it was signed by both sides.

The statute is not interested in the filing of an agreement that does not represent the final agreement of the parties. The statute, as I read it, is interested in what the parties have actually agreed to. And the fundamental thing in this case is that both sides understood that there would be no agreement until it was signed by both sides and regarded by both sides as a final draft.

That is the whole purpose of an agreement in principle and the recitation in the agreement in principle that there would be further documents to be signed which would represent the actual agreement of the parties.

But even the agreement in principle was not executed by both sides and, therefore, did not become an agreement, an enforceable agreement, until December 16.

It could be argued that even the agreement in principle need not have been filed since it contemplated further agreements which would constitute the real agreements between the parties.

[22] I'm not sure that that's not the correct interpretation of what occurred here. Surely, if there had been a breach of the agreement the parties reached, it would not have been brought on the agreement in principle; it would have been brought on the license agreement or on the settlement agreement which contained all of the terms, and more terms than were contained in the agreement in principle.

And if January 14 is the appropriate date, clearly those agreements were executed long after the interference was terminated.

The same is true of the agreement in principle of December 16 since it was not fully executed and thus not an agreement in my view until six days after the mandate was filed. And the latest act I can conceive would be considered the termination of the interference would be the filing of that mandate.

I do not base my decision on either of the two new arguments which CTS has made here today and during the proceeding. That is, I do not base my decision on the argument that the Section 146 suit resulted in a termination of the interference at the time it was filed.

CTS may be correct in that argument, but I have not considered it [illegible]y and do not adopt it.

Secondly, I believe that Piher is correct in [23] its argument that the filing of the copy of the consent judgment would not constitute compliance with Section 135(c).

What we had in this Court was a consent judgment with agreements under seal; those agreements were not subject to the inspection of the Department of Justice without

an order so providing, which would have required their making a motion before me. And that is not the simple inspection procedure contemplated by Section 135(c), in my opinion.

Finally, I deny CTS' motion for attorneys' fees.

While I believe the motion of Piher to modify the judgment is without merit, I do not find that it is frivolous, and am unable to conclude that it is so obviously lacking in merit that it should be regarded as having been brought for harassment or only for purposes of delay or one of the reasons that might justify awarding fees.

The reviewing Court might feel differently; and if it does, I would be happy to carry out any mandate to award fees.

I believe that, whatever the merits of the arguments of the parties at various points during this long and arduous litigation, this latest motion is an imposition upon CTS, which negotiated in good faith and in good faith entered into what it believed were agreements that would terminate [24] the litigation.

It appears to me that neither side was aware of Section 135(c) at the time of the settlement or, in the alternative, that neither side believed it to be applicable.

In any event, I believe this motion to be an example of how technicalities can be used to prolong controversies.

The Piher witnesses talked about how they believed CTS has prevailed on technicalities in this case. And it seems anomalous to me that they were apparently unaware of how highly technical their own motion to modify is.

For those reasons the motion of Piher International Corporation and all other defendants to modify the final judgment order of January 25, 1981, is denied.

We have money on deposit, and that money has been held pursuant to a stay pending resolution of this motion.

I am now inclined to dissolve the stay and to order the funds on deposit with the Clerk to be turned over to CTS at such time as whatever obligations they are presently invested in come due or at such other time as is appropriate.

All right. That will be the order.

[25] MR. WYSS: Your Honor, do you want us to draft the order, or is it all drafted?

THE COURT: I think that's it. What I have just said is my order.

And what you might do is present a very short draft order, simply denying the motion and referring to these findings and conclusions; and in the event of an appeal, those findings and conclusions can be written up and made a part of the file.

There will probably be a motion to stay this order pending appeal, and from what I have already said, you can anticipate my ruling on that motion.

And to save everybody time, I'm going to enter that order now: Stay of this order pending appeal is denied. You can put that in the order.

(Which were all the proceedings had and taken in said cause on said date.)

[26] Certificate of Official Court Reporter omitted in printing.

APPENDIX E

LEGISLATIVE HISTORY

PATENT INTERFERENCES—PUBLIC NOTICE OF SETTLEMENTS

For text of Act see p. 1126

Senate Report No. 2169, Sept. 27, 1962 [To accompany H.R. 12513]
House Report No. 1983, July 17, 1962 [To accompany H.R. 12513]
The Senate Report is set out.

Senate Report No. 2169

THE Committee on the Judiciary, to which was referred the bill (H.R. 12513) to provide for public notice of settlements in patent interferences, and for other purposes having considered the same, reports favorably thereon, with an amendment in the nature of a substitute, and recommends that the bill, as amended, do pass.

PURPOSE

The purpose of this bill is to amend the patent laws to require the filing in the Patent Office of agreements settling patent interference proceedings. When two or more applicants claim substantially the same invention an interference is declared in order to determine which applicant is entitled to priority. Interference proceedings may be terminated in a manner hostile to the public interest by using patent interference settlement agreements as a means of restricting competition. To make such a practice more difficult the bill requires the filing of such agreements in the Patent Office.

PRINCIPAL PROVISIONS

The bill provides that no agreement or understanding between parties to an interference proceeding made in

connection with or in contemplation of the termination of the proceedings shall be enforcible unless in writing and a copy thereof filed in the Patent Office before the termination of the prceedings. The Commissioner is required to give notice of the filing requirement prior to the termination of the interference proceeding, and if the Commissioner does not give such notice until a later time, the parties may file the required agreements within 60 days of the receipt of such notice. It is further provided that the Commissioner of Patents may, on a showing of good cause for failure to file, permit the filing of an agreement during the 6-month period subsequent to the termination of the proceedings as between the parties.

The bill provides that if the party filing such agreements so requests, the filed copy shall be kept separate and made available only to Government agencies on written request, or to any person on a showing of good cause. H.R. 12513 also provides that failure to file a copy of a patent interference settlement agreement shall render permanently unenforcible any patent, of the parties, involved in the interference or any patent subsequently issued upon any application of the parties so involved. It is further provided in the bill that any discretionary action of the Commissioner shall be reviewable under section 10 of the Administrative Procedure Act.

STATEMENT

The Subcommittee on Patents, Trademarks, and Copyrights earlier this year withheld its approval from that portion of the Drug Industry Act of 1962, S. 1552, which would have required that every contract, agreement, or understanding entered into by an applicant for a drug patent with any other person, granting any rights with respect to the patent application, or for the purposes of having a patent granted, be in writing and filed with the Commissioner of Patents. This committee sustained the action of the subcommittee in refusing to approve this provision of the drug bill so as to permit the subcommittee to consider legislation then pending in the House of

Representatives which would have required the filing of all agreements pertaining to interference settlements and not confined merely to drug patents.

The following reports from the Departments of Commerce and Justice are herewith attached.

THE SECRETARY OF COMMERCE,
Washington, D. C., March 22, 1962.

HON. JOHN W. MCCORMACK,
Speaker of the House of Representatives,
Washington, D. C.

DEAR MR. SPEAKER: The Department of Commerce urges the introduction and enactment of the enclosed draft legislation to provide for public notice of settlements in patent interferences.

The President in his message on consumers, released on March 15, urged enactment of legislation to provide for the publication of the terms of all settlement agreements between different persons applying for patent rights on the same invention.

The purpose of such a statute is to provide assurances by the resulting availability of information to the public and to law enforcing agencies of the Government that such agreements do not have the effect of minimizing competition in a manner which is either illegal or, to the extent that publicity deters, otherwise detrimental to the public welfare.

Agreements or understanding made in connection with or in contemplation of the termination of an interference must be filed in the proceedings to be enforceable even between the parties.

To provide notice that there is present such an agreement in the record, available to the public, at the Patent Office, the Patent Office will in such a case, upon the ter-

mination of an interference involving a patent or an application on which a patent has subsequently issued, publish such information in the Official Gazette, a weekly publication of the Patent Office. Presently, in accord with section 135 of title 35 of the United States Code, and rule 11 of the Rules of Practice of the United States Patent Office in Patent Cases, information is published with respect to interferences involving patents in which the decision is adverse to the patentee.

It will thus be seen that the agreement will be available to the public, at the Patent Office, and that an easily available notice giving a patent number for reference to the record will be available to assist in looking up the agreement.

We are advised by Bureau of the Budget that enactment of this proposal would be in accord with the program of the President.

Sincerely yours,

EDWARD GUDEMAN,
Acting Secretary of Commerce.

DEPARTMENT OF JUSTICE,
OFFICE OF THE DEPUTY ATTORNEY GENERAL,
Washington, D. C., April 30, 1962.

HON. EMANUEL CELLER,
Chairman, Committee on the Judiciary,
House of Representatives, Washington, D. C.

DEAR MR. CHAIRMAN: This is in response to your request for the views of the Department of Justice on H.R. 11015, a bill to provide for public notice of settlements in patent interferences.

This legislation was introduced to implement a recommendation made by the President in his consumer message, submitted to the Congress on March 15. The Department of Justice urges its enactment.

Interference proceedings are conducted by the Patent Office in order to determine which applicant is entitled to priority when it is found that two or more applicants are claiming substantially the same invention. Before the parties submit evidence relating to the issue of priority, they are given the right to make a motion to dissolve or reform the interference if they believe the interfering claim is unpatentable or does not properly define the invention. If a party is ultimately successful in having the interference claim held unpatentable, he prevents himself and others from being precluded from making, selling or using the device which was the subject of the interfering claim and thereby opens the field to competition. The issue of patentability is heard and decided before the question of chronological priority of invention is reached. Parties to interferences frequently move to dissolve on the ground of unpatentability and are often successful. Interferences may also serve to restrict or narrow unwarrantedly broad claims before the patent application issues as a patent. The public is thus given the benefit of free and open competition since all persons, including the patent applicants, may make, use, or sell what is covered by the claim; furthermore, the issuance of invalid patents is prevented. In short, an interference permits the true first inventor to establish his priority and on occasion serves as an important check to prevent the issuance of unduly broad patent monopolies.

Recent experience has indicated that parties to interferences have, in some cases, used those proceedings to serve their own ends with little or no regard for the public interest. Interference settlement agreements have been entered into for the purpose of obtaining patents as broad as possible in order that they may be used by the parties to eliminate competition. The Supreme Court in holding a private interference settlement to be so inequitable as to preclude the enforcement of the resulting patent stated in Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806, 815-816, 65 S.Ct. 993, 80 L.Ed. 1381 (1945):

"* * * The possession and assertion of patent rights are 'issues of great moment to the public' [citing cases]. A patent by its very nature is affected with a public interest. As recognized by the Constitution, it is a special privilege designed to serve the public purpose of promoting the 'progress of science and useful arts'. At the same time, a patent is an exception to the general rule against monopolies and to the right to access to a free and open market. The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other equitable conduct and that such monopolies are kept within their legitimate scope. The facts of this case must accordingly be measured by both public and private standards of equity."

The purpose of this legislation is to make it more difficult for patent applicants to use an interference settlement agreement as a means of violating the antitrust laws. It seeks to accomplish this purpose by providing that no such agreement or understanding shall be enforceable unless all of its terms are in writing and filed prior to the termination of the interference proceeding. It is our view that this prohibition would not adequately deter violations of the antitrust laws. It is therefore suggested that the measure be amended to provide that parties to an interference settlement agreement shall be precluded from enforcing the resulting patent unless a copy of the settlement agreement has been filed with the Patent Office prior to the termination of the interference. In order to protect innocent parties who inadvertently fail to file a copy of their settlement agreement, the Commissioner of Patents should be given the authority to entertain, at any time during the 6-month period subsequent to the termination of the interference, a petition by either party for leave to file a copy of the agreement, which petition may be granted on a showing of good cause for the failure to file within the time prescribed. Further, it is suggested that the bill should provide a right of action in the United States to obtain a civil penalty for failure to file a copy of an interference agreement.

If the committee desires it, the Department of Justice will gladly lend its assistance in drafting provisions embodying the amendments herein proposed.

The Bureau of the Budget has advised that there is no objection to the submission of this report.

Sincerely yours,

NICHOLAS DEB. KATZENBACH,
Acting Deputy Attorney General.

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No. 83-1880

IN THE

Supreme Court of the United States

OCTOBER TERM, 1983

PIHER INTERNATIONAL CORPORATION and PIHER SOCIEDAD ANONIMA,

Petitioners,

v.

CTS CORPORATION,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

ROBERT L. ROHRBACK
WALTHER E. WYSS *
MASON, KOLEHMAINEN, RATHBURN & WYSS
20 North Wacker Drive - Suite 4200
Chicago, Illinois 60606
(312) 621-1300
Attorneys for CTS Corporation

* Counsel of Record

Midwest Law Printing Co., Chicago 60611, (312) 321-0220

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TABLE OF CONTENTS

	Page
TABLE OF CASES	ii
STATEMENT OF THE CASE	1
FACTUAL BACKGROUND	4
THE ISSUES PRESENTED	11
REASONS FOR DENYING THE PETITION	12
I. THE FEDERAL CIRCUIT'S INTERPRETATION OF THE STATUTE IS CORRECT AND NO CONFLICT EXISTS WITH ANY REPORTED DECISION	12
II. ADOPTION OF A BROAD INTERPRETATION OF THE STATUTE WOULD NOT CHANGE THE RESULT BELOW	16
CONCLUSION	18

APPENDICES

F— Defendants' Motion under Rule 60(b)(6) to Modify Judgment Order	F-1
G— Stipulation of Parties	G-1
H— Notice of Termination of the Interference	H-1

TABLE OF CASES

	Page
Application of Jones, 542 F.2d 65 (CCPA 1976)	17
Continental Can Company v. Schuyler, 326 F. Supp. 283 (D.D.C. 1970)	17
Guillory v. County of Orange, 731 F.2d 1379 (9th Cir. 1984)	15
Moog, Inc. v. Pegasus Laboratories, Inc., 376 F.Supp. 439 (E.D. Mich. 1973), *affirmed*, 521 F.2d 501 (6th Cir. 1975)	13
Old Dominion Box Co. v. Continental Can Co., 273 F.Supp. 550 (S.D.N.Y. 1967), *affirmed*, 393 F.2d 321 (2nd Cir. 1968)	14
PPG Industries, Inc. v. Bausch & Lomb, Inc., 205 USPQ 914 (W.D.N.Y. 1979)	13
United States of America v. FMC Corp., 215 USPQ 43 (E.D. Pa. 1982), reversed on other grounds, 717 F.2d 775 (3rd Cir. 1983)	12, 13, 14

OTHER AUTHORITIES

Rule 52(a) Federal Rules of Civil Procedure	15
Rule 60(b)(6) Federal Rules of Civil Procedure	1, 10
35 U.S.C. §135(c)	11, 12, 13, 14, 16, 17

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PIHER INTERNATIONAL CORPORATION and PIHER SOCIEDAD ANONIMA,

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Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

STATEMENT OF THE CASE

The District Court's denial of Petitioner's Motion under Rule 60(b)(6) of the Federal Rules of Civil Procedure was predicated upon explicit findings of fact entered after hearing the testimony of a number of witnesses called by each party and a full consideration of all documentary evidence presented by both parties. These findings of fact were reviewed by the Court of Appeals for the Federal Circuit and none of them is directly challenged or asserted

to be clearly erroneous in the Petition although Petitioner* repeatedly asserts facts directly contrary to the findings.

The principal findings which prompted the District Court to deny Petitioner's motion were:

(1) the interference terminated at least by November 4, 1981, which was more than two weeks prior to the first meeting between the parties on November 23 to discuss settlement of the accounting then in progress (D-12)**;

(2) Petitioner failed to carry its burden of proof that settlement of the interference or the possibility of Petitioner's filing a petition for writ of certiorari seeking review of a final appellate court decision adverse to it in Petitioner's 35 U.S.C. §146 suit were even discussed during the settlement meeting (D-2 to D-10);

(3) there was no evidence to indicate that the possibility of Petitioner filing a petition for writ of certiorari played any part whatsoever in the settlement of the accounting matters even if one assumed that this subject was casually mentioned during the November 23, 1981 meeting (D-9 to D-12);

(4) the parties did not reach a mutually acceptable preliminary agreement in principle until December 16, 1981 and during the period between that date

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* In the first court decision rendered in this lengthy litigation, the two named petitioners were found to be *alter ego* companies [i.e. 184 USPQ 399, 400-401] and, hence, they are referred to herein by the singular term, "Petitioner".

** The Appendices to the Petition are referred to herein as A____, B____, C____, D____ and E____, the Petition is referred to as P____, and the Appendices to this brief are referred to as F____, G____ and H____.

and November 23, 1981 neither party was bound by any of the partial matters tentatively discussed previously (D-13 to D-15);

(5) the final settlement agreements based in part on the agreement in principle were negotiated during the period after December 16, 1981 and were completed on January 14, 1982 (D-15);

(6) Petitioner conceded in the District Court that the interference terminated on December 10, 1981 (i.e. when the Court of Appeals for the Seventh Circuit issued a second mandate a few days after it denied Petitioner's request for reconsideration of the final decision in the suit under 35 U.S.C. §146) (F-3, 5, 9, 10);

(7) because of these facts, among others, there was no causal connection between the agreements settling the accounting matters and the termination of the interference (D-11).

Petitioner never alleged in the District Court that it was not required to show a causal connection between the termination of the interference and the settlement (C-2) but, to the contrary, urged that it could and would produce sufficient evidence to establish such a connection. It attempted to do so in an evidentiary hearing but the District Court found the evidence insufficient to sustain Petitioner's burden of proof (D-2 to D-12). In Petitioner's appeal to the Court of Appeals for the Federal Circuit it argued that the agreements "were the direct cause of the termination" (B-11) and then urged inconsistently and *for the first time* that such causal connection was "irrelevant" and need not be shown.

FACTUAL BACKGROUND

The present litigation began in 1972 when Respondent filed suit charging Petitioner with infringement of four U.S. patents including Patent No. 3,670,285 (hereinafter '285). In a decision reported at 184 USPQ 399, the District Court found Petitioner had infringed three of the patents and found those patents valid, the issue of infringement of the '285 patent having been removed by stipulation and the court also found that Petitioner had failed to show the '285 patent was invalid because of Petitioner's own offers for sale. During the pendency of the latter suit (i.e. on June 6, 1973) Petitioner filed an application for reissue of its U.S. patent No. 3,662,314 adding 19 claims which it copied from the '285 patent. The U.S. Patent and Trademark Office (hereinafter "PTO") declared Interference No. 98,455. Piher appealed from the District Court decision and in a decision reported at 527 F.2d 95, which was authored by Judge (now Mr. Justice) Stevens, the appellate court affirmed the District Court on every issue except the "on sale" question which was remanded for a new trial and was assigned to Judge Grady. A petition for writ of certiorari was denied. 424 U.S. 978, 96 S.Ct. 1485 (1976).

In 1976 Respondent filed Civil Action 76 C 1152 again charging Petitioner with infringement of the '285 patent and that suit was also assigned to Judge Grady. On December 7, 1976 pursuant to stipulation (G1, G2), the latter case was stayed under conditions which provided that if Respondent prevailed in the interference and on the remanded "on sale" issue in decisions which "*become final*" a judgment of infringement and validity of the '285 patent would be entered against Petitioner. The "on sale" issue was decided in Petitioner's favor in an unpublished

decision but, on appeal, the judgment entered by Judge Grady was reversed in a decision reported at 593 F.2d 777 (7th Cir. 1979). Petitioner moved for a stay of the appellate court mandate but the motion was denied because the court said there was little likelihood a petition for writ of certiorari would be granted. Such a petition was thereafter denied. 444 U.S. 884, 100 S.Ct. 175 (1979). Judge Grady ordered that an accounting proceed to determine the damages flowing from Petitioner's infringement of all four patents of Respondent. The accounting was prolonged, required numerous court appearances and "dragged out for years" (D-10).

All available evidence relating to the priority of invention issue was taken in the interference and presented to the PTO. In April, 1978 the PTO, in a decision reported at 200 USPQ 597, found Respondent was the first inventor of most of the subject matter common to the '285 patent and Petitioner's patent*. Petitioner filed suit under 35 U.S.C. §146 seeking review of the PTO decision and, in a decision dated September 27, 1979, the District Court reversed and remanded to the PTO that portion of the PTO decision which held Petitioner was precluded by "collateral estoppel" from proving an invention date earlier than that of Respondent. The PTO on April 18, 1980 in an unpublished decision again awarded priority of 18 of the 19 counts (i.e. claims) to Respondent without taking any further evidence. Petitioner filed a new suit under 35 U.S.C. §146 and in a decision dated March 9, 1981, which is reported at 210 USPQ 806, the District Court affirmed the PTO decision, whereupon Petitioner appealed to the Seventh Circuit Court of Appeals. On November 4, 1981 the District Court judgment was affirmed by a

* Priority as to one claim was found in Petitioner's favor but that claim is not involved in this petition.

unanimous decision reported at 664 F.2d 122 and the mandate was issued on November 6, 1981*. As Judge Grady found:

> "The interference was *fully litigated* before the Patent Office, before the District Court, before the Court of Appeals. As a practical matter it was over."** (D-17)

On November 10, 1981 a "Judgment Order" was entered by Judge Grady in Civil Action 76 C 1152 because of the stipulation (G-1, G-2) and because Respondent had prevailed in "*final*" decisions in both the interference and the "on sale" issue. The judgment explicitly found Respondent was the "*prevailing party*" on both issues, enjoined Petitioner from further infringement of the '285 patent and awarded Respondent damages in an amount to be determined by the accounting already in progress. On November 18, 1981 a formal writ of injunction was issued by the District Court and on November 21, 1981 the PTO, relying upon the November 4 decision and the November 6 mandate of the Seventh Circuit Court of Appeals issued a formal notice of termination of the interference (H-1) which has never been vacated, altered or superseded by the PTO. Neither the December 2 decision denying Petitioner's Petition For Rehearing nor the December 10 mandate was ever sent to the PTO by either party and no attempt was made by Petitioner subsequent to November 21, 1981 to alter the terminated status of the interference.

On November 23, 1981 management representatives of Respondent and Petitioner met *for the first time* to at-

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* This mandate was recalled shortly after Petitioner filed a Petition for Rehearing of the appellate court decision and at about the same time (i.e. on December 2, 1981) the appellate court denied rehearing without opinion. On December 10, 1981 a renewed mandate was issued.

** Emphasis added throughout.

tempt to discuss and settle "the accounting" (D-10) and not "legal questions" (D-3)*. It was admittedly a "meeting between businessmen" and "laymen" were to negotiate (D-3). The District Court found:

> "Had it been intended to discuss legal questions, lawyers would have been present in their capacity as lawyers. That is precisely what the parties did not intend would occur". (D-3)

Neither Petitioner's then pending petition for rehearing in the appellate court nor the interference was discussed. Petitioner did not sustain its burden of showing that possible filing of a petition for certiorari seeking Supreme Court review was discussed (D-2 to D-4). Near the close of the meeting Respondent's representatives presented a number of basic terms that were fundamental before any final settlement agreement could be consummated and gave Petitioner twenty-four hours to accept those basic terms. The following day, Petitioner's counsel conveyed Petitioner's acceptance of these basic terms and Respondent's counsel on November 25th sent by Telex a draft proposal for discussion purposes. Petitioner's counsel understood that this proposal was a "draft" and he rejected it because it "went beyond" the discussion at the November 23 meeting**. Petitioner's management found the proposal unacceptable because of omission of a matter of concern to Petitioner. Petitioner instructed its counsel to negotiate further with Respondent and he redrafted the proposal and sent a counter-proposal, which he still regarded as a "draft", to Respondent for consideration**.

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* Petitioner's naked assertion that the meeting was for the purpose of discussing and settling the interference litigation (P 8) is directly contrary to the District Court's finding as to the purpose of the meeting and is also contrary to the record.

** The quotes are from the transcript of the testimony of Petitioner's own counsel.

Between November 25 and December 10 the parties continued to exchange "draft" proposals each including a number of changes from the preceding one (D-14). Petitioner's counsel understood that the changes Petitioner proposed were subject to "review by the CTS executives before they would agree" and that at least some of these changes had to be approved by Respondent's counsel*. By December 11, 1981 Respondent was satisfied with the "Agreement In Principle" (i.e. a preliminary agreement which would hopefully lead to a final settlement of the accounting) and it sent a copy, signed by its counsel, to Petitioner for signature, which signature was not affixed until December 16, 1981 (D-14). It was understood between the parties that no settlement would be made in the absence of a "signed document" (D-14). Judge Grady found:

> "I reject completely the argument of Piher that these parties had entered into what they each believed was a binding agreement on the 25th of November." (D-13)

He found the various proposals exchanged prior to December 11, 1981 were "obviously preliminary and preparatory drafts" (D-14) and he found "as a fact that Piher would have turned its back on any of these" by asserting they "were not final" (D-14). Judge Grady further found:

> "It is perfectly apparent from this evidence that both sides regarded the writings that were exchanged prior to the signing of the agreement in principle on December 16 as drafts of an agreement that would not be considered binding until it was signed by both sides." (D-14)

The December 16 "Agreement In Principle" (B-6) states that the parties "*shall* [i.e. something to be done in the

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* The quote is from the transcript of the testimony of Petitioner's own counsel.

future] join in an understanding for a release" of each other from "*any claim or claims* . . . which either party has or could have asserted against the other" in all of the aforementioned litigation. The Agreement *does not explicitly mention the interference and does not refer to the termination* of the interference. As the District Court found, the mutual release of claims was a "boilerplate" type term commonly employed in settlement agreements (D-6, D-7).

The parties proceeded to negotiate the final agreements necessary to implement the "Agreement In Principle" and by January 14, 1982 (D-13, D-15) they signed a "License Agreement", a "Stipulated Agreement" and a "Stipulated Consent Judgment In Lieu of Accounting" all of which, together with the "Agreement In Principle" were filed in the District Court (D-15)*. A copy of the consent judgment, which refers to the other three agreements, was promptly filed in the PTO but the latter three agreements were not filed in the PTO by either party.

The District Court found that both parties "know that there is nothing anti-competitive" about any of the agreements (D-14). The "Settlement Agreement" (B-6, B-7) lists three "*pending*" matters (i.e. three civil actions) and it refers to the "interference" but that proceeding is *not* listed as "*pending*".

In view of the foregoing facts the District Court found that the interference terminated on November 4, 1981 when the Seventh Circuit Court of Appeals rendered its final decision in Petitioner's second suit under 35 U.S.C. §146 (D-12). The court said the latter decision related to a factual issue that had been decided favorably to Respon-

* All except the Consent Judgment were filed under seal and, hence, were available only upon order of the court (D-16).

dent both in the PTO and in the District Court and, at the time of the November 23 meeting, both parties implicitly recognized there was virtually no chance that the Court of Appeals would grant the pending petition for rehearing or that the Supreme Court would grant any subsequent petition for certiorari (D-7 to D-10). In view of the aforementioned finding that there was no agreement between the parties until at least December 16, 1981 and Judge Grady's further finding that the interference terminated at the very latest by December 10, 1981, just as Petitioner had conceded in the papers it submitted to him (F-3, 5, 9, 10)*, Judge Grady found there was no agreement in writing that could have been filed prior to the termination of the interference (D-15). He further found that there was no "causal connection" between the agreements settling the accounting and the termination of the interference, which, in accordance with the court's findings, was terminated by a mandate and/or decision of the Court of Appeals and *not by any agreement between the parties* (D-11).

The Court of Appeals held that Judge Grady had not abused his discretion in denying Petitioner's Motion under Rule 60(b)(6) because the finding of a lack of causal connection was not shown to be clearly erroneous (B-11 to B-14). The Appellate Court did not comment upon the District Court's findings as to the date of the settlement agreement or the date of termination of the interference because it agreed with Judge Grady that Petitioner had failed to prove that the settlement agreements played any role in terminating the interference (B-12 to B-14).

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* Petitioner's present assertion that the interference did not terminate until January 25, 1982 (P 9) is not only contrary to Judge Grady's explicit findings (D-12, D-15) but is also contrary to the concession Petitioner made in the briefs it submitted to Judge Grady (F-3, 5, 9, 10).

THE ISSUES PRESENTED

The first three argumentative issues asserted by Petitioner are not even remotely presented by the present case which was decided by the District Court and the Court of Appeals on the specific facts here extant. The decisions below established no far reaching principles and certainly did not emasculate or even erode the statute*.

The sole issues raised are:

(1) Whether, upon the specific facts of this case, there was even a tenuous causal connection between the settlement agreements and the termination of the interference.

(2) Whether 35 U.S.C. §135(c) requires or even permits the filing of settlement agreements relating to an accounting for damages when the negotiations leading to such agreements did not even begin until after the interference had been terminated by full litigation and no agreement was reached until after such termination.

Since the second question is clearly answered in the negative by the explicit terms of the statute and the first question raises only factual issues which are not even contended by Petitioner to be "clearly erroneous" and do not lend themselves to review by this Court, no issue is presented which warrants granting the petition.

* During the long history of administration of 35 U.S.C. §135(c), no reported decision relates to a case, the ultimate outcome of which would have been changed if the courts had adopted the construction of the statute urged by Petitioner. Thus, the situation adopted by both courts below has not impeded enforcement of the statute.

REASONS FOR DENYING THE PETITION

I.

THE FEDERAL CIRCUIT'S INTERPRETATION OF THE STATUTE IS CORRECT AND NO CONFLICT EXISTS WITH ANY REPORTED DECISION.

The holding of the District Court and the Court of Appeals for the Federal Circuit interpreting 35 U.S.C. §135(c) to require at least a tenuous causal "connection" between an agreement and the termination of an interference is solidly grounded upon prior decisions, which have unanimously so interpreted that statute. No reported decision holds to the contrary. Therefore, the two lower court decisions in the present case are not in conflict with any reported decision of either a district court or any appellate court.

In *United States of America v. FMC Corp.*, 215 USPQ 43, 50 (E.D. Pa. 1982), cited in the Petition (P 11, 12), the government made the same contention regarding interpretation of 35 U.S.C. §135(c) as Petitioner makes in its Petition, namely, that the phrase "in connection with or in contemplation of" should be given a "broad, plain meaning interpretation of the statutory language". Such an interpretation would have resulted in violation of the statute because the four written unfiled agreements relating to foreign patent rights were, as the *FMC* court found, "negotiated at the same time as the United States agreement" and all of the agreements were urged to be one "ball of wax". FMC argued that "in connection with or in contemplation of" refers only to "agreements either causally related to the termination of the interference or which are a significant factor in causing the termination of the interference". The court found "the legislative

history is of no assistance in choosing" between the respective positions of the parties*.

After weighing the pros and cons of the two different interpretations respectively urged by the parties, the *FMC* court said:

> "In addition to the concept that justice abhors a forfeiture, there is support in the cases for defendant's narrow interpretation of 'in connection with or in contemplation of'."

The court then proceeded to analyze very carefully all of the pertinent prior decisions. It first discussed the District Court decision in *Moog, Inc. v. Pegasus Laboratories, Inc.*, 376 F.Supp. 439, 447-448 (E.D. Mich. 1973) and the affirming decision of the Sixth Circuit Court of Appeals, which is cited in the Petition (P 11, 15, 16) and which "stressed the district court's finding that there was a 'causal connection' between the agreement . . . and the termination of the interference." The *FMC* court, therefore, inferred that "at least in the Sixth Circuit a narrow interpretation of 'in connection with or in contemplation of' has been accepted".

The *FMC* court then analyzed *PPG Industries, Inc. v. Bausch & Lomb, Inc.*, 205 USPQ 914 (W.D.N.Y. 1979) and found that decision "clearly suggests the acceptance

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* While Petitioner quotes extensively from the legislative history (P 3-7) all of these quotes, as well as all of Petitioner's quotes from prior cases that have interpreted 35 U.S.C. §135(c), relate to generalities which are not in dispute between the parties and were not questioned in the decisions by Judge Grady and the Court of Appeals for the Federal Circuit. As the *FMC* court said, the legislative history relied upon by Petitioner is not helpful in determining whether the statute requires a causal connection of some sort between the agreement and the termination of the interference.

of a narrow interpretation of 'in connection with or in contemplation of' " and it found precisely the same suggestion in *Old Dominion Box Co. v. Continental Can Co.*, 273 F.Supp. 550 (S.D.N.Y. 1967), affirmed on other grounds, 393 F.2d 321 (2nd Cir. 1968).

The *FMC* court then said the "causal relationship between the unfiled agreements and the termination of the interference need not be strong" but, "in order for there to be a violation of 35 U.S.C. §135(c) at the very least the unfiled agreements *must affect the parties'* attitude toward the interference". In the case at bar, the District Court found that the settlement agreements did not affect the "parties' attitude toward the interference" both because the interference had terminated prior to the agreements and because the sole remaining possibility for further litigation of Petitioner's 35 U.S.C. §146 suit was the filing of a petition for writ of certiorari, which the court found was not only not discussed between the parties but would have been a totally useless step and one which neither party regarded as anything but sheer desperation on the part of Petitioner (D-8 to D-11). Thus, the possibility that Petitioner might resort to such a petition played no role in the settlement or in the termination of the interference and did not affect the *parties'* attitude towards the litigation (D-8 to D-10). The court in the *FMC* case, like Judge Grady in the case at bar (D-11), found no causal connection whatsoever between the unfiled agreements and the termination of the interference although the *FMC* court did find that the Government had standing to challenge the validity of FMC's patent because of the failure to file the agreements relating to the foreign patents. On appeal, the Third Circuit Court of Appeals reversed as to the standing issue and, hence, did not reach the other issues because the lack of standing by the plaintiff disposed of the controversy.

In the present case, Judge Grady held:

> "Plaintiff [i.e. Respondent] argues that this statute [i.e. 35 U.S.C. §135(c)] contemplates only agreements which have a causal relationship to the termination of the interference, and *defendant [i.e. Petitioner] does not contend otherwise.* The phrase 'made in connection with or in contemplation of' seems clearly to import a causal relationship between the agreement and the termination of the interference. I adopt this interpretation which is consistent with the purpose and the legislative history of the statute." (C-2)

The issues which Petitioner now asks this Court to review were, therefore, not even urged before Judge Grady but were, instead, raised for the first time on appeal as an aside just in case that Court disagreed with Petitioner's principal argument that the agreements "were the direct cause of the termination" (B-11). Before Judge Grady, Petitioner tacitly conceded that it was required to prove the causal connection it now disowns and it insisted upon an extensive evidentiary hearing wherein it attempted unsuccessfully to adduce such proof*.

Petitioner does not contend, much less show, that the finding of the courts below as to the lack of any causal connection between the settlement agreements and the termination of the interference is "clearly erroneous" within the meaning of Rule 52(a) of the Federal Rules of Civil Procedure. Since the finding is supported by substantial evidence no such contention can be made truthfully.

The petition should be denied because the holdings of the two courts below are consistent with all reported decisions and no conflict exists between appellate courts as to

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* As a general rule, one may not urge as a ground for reversal a theory not presented to the trial court. *Guillony v. County of Orange*, 731 F.2d 1379, 1383 (9th Cir. 1984).

the proper interpretation of 35 U.S.C. §135(c). The purported issues as to which Petitioner seeks review have been fully considered by these prior decisions and no lower court has either agreed with Petitioner or evidenced any difficulty whatsoever in applying the statute. The issues posed by Petitioner simply to not exist in this fact-oriented case and certainly do not warrant the time and attention of the Court.

II.

ADOPTION OF A BROAD INTERPRETATION OF THE STATUTE WOULD NOT CHANGE THE RESULT BELOW.

Even if the interpretation of 35 U.S.C. §135(c) by the two lower courts were incorrect, the result below would not be changed because the lower court's finding that the interference terminated by November 4, 1981 when the Seventh Circuit Court of Appeals rendered its decision in the interference (D-12) obviously means that any agreements or understandings reached after that date could not possibly fall within the statute. The statute does not permit, much less require, the filing of agreements or understandings reached subsequent to the termination of an interference since, by its explicit language, it requires the agreements or understanding within its purview to be filed "prior to termination". Clearly, an agreement or understanding reached after an interference has terminated cannot be filed prior to such termination. The District Court held that "§135(c) requires the filing of agreements which have been *reduced to writing prior to the termination of the interference* and no others". (C-4) That holding is not challenged in the Petition. In the present case, the interference terminated on November 4, 1981 (D-11, D-12) nearly three weeks before the parties first met to discuss the possibility of settling the accounting then in progress.

The District Court's findings that the very latest conceivable date for termination of the interference was December 10, 1981 when the second mandate of the Seventh Circuit Court of Appeals issued (D-12, D-13, D-15)* and that no agreement or understanding mutually acceptable to the parties was reached at the earliest until December 16, 1981 when Petitioner signed the preliminary Agreement In Principle (D-14, D-15) also means the settlement agreements were not within the statute because they were not reached until after the interference terminated. Since no mutually acceptable agreement or understanding existed in writing prior to December 10 when the second appellate court mandate issued, it would have been impossible to file any such agreement prior to that date.

Petitioner obviously did not believe the settlement agreements were required by 35 U.S.C. §135(c) to be filed in the PTO since *it* did not file them even though the statute would have compelled such filing if Petitioner's position were correct. Petitioner has never disclaimed or dedicated to the public its own patent No. 3,662,314 even though it should have done so if it genuinely believed that it had violated 35 U.S.C. §135(c) by its failure to file the agreements. Petitioner's entire argument relating to the purported violation of 35 U.S.C. §135(c) is a contrived distortion of the statute in an attempt to renege on settlement agreements reached after almost ten years of litigation (D-13, D-14). Nothing in this case warrants granting of the Petition to prolong further this seemingly endless litigation.

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* See *Application of Jones*, 542 F.2d 65, 69 (CCPA 1976) and *Continental Can Company v. Schuyler*, 326 F.Supp. 283, 284 (D.D.C. 1970), which are in accord, and Petitioner's own concession (F-3, 5, 9, 10). That it is the PTO practice to terminate an interference when an appellate court decision is rendered is also apparent from its November 21, 1981 termination notice in the case at bar (H-1).

CONCLUSION

For all of the foregoing reasons, the Petition For Writ Of Certiorari To The Court Of Appeals For The Federal Circuit should be denied.

Respectfully submitted,

ROBERT L. ROHRBACK
WALTHER E. WYSS*
MASON, KOLEHMAINEN, RATHBURN & WYSS
20 North Wacker Drive - Suite 4200
Chicago, Illinois 60606
(312) 621-1300
Attorneys for CTS Corporation

* Counsel of Record

APPENDIX F

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

CTS CORPORATION, *Plaintiff,* v. PIHER INTERNATIONAL CORPORATION, and PIHER SOCIEDAD ANONIMA, *Defendants.*	)	Civil Action No. 72 C 1891 and Civil Action No. 76 C 1152

DEFENDANTS' MOTION UNDER RULE 60(b)(6) TO MODIFY JUDGMENT ORDER HEREIN DATED JANUARY 25, 1982 TO CONFORM TO THE FACT THAT THE '285 PATENT AND AGREEMENTS "A", "B", AND "C" RECITED IN THE JUDGMENT ORDER ARE NOW PERMANENTLY UNENFORCEABLE BY OPERATION OF LAW (35 U.S.C. Section 135(c))

INTRODUCTION

Defendants, Piher International Corporation and Piher Sociedad Anonima, hereby respectfully move this Honorable Court under Rule 60(b)(6), Federal Rules of Civil Procedure, to modify the Consent Judgement Order entered herein on January 25, 1982, to conform to the fact that the three agreements ("A", "B", and "C") and one of the patents ('285) recited in the Consent Judgment Order have

become permanently unenforceable by operation of law, in accordance with the provisions of 35 U.S.C. Section 135(c) (a copy of Section 135(c) is attached hereto for convenience as Exhibit A).

This statute requires all agreements made in connection with the termination of an interference proceeding in the United States Patent and Trademark Office be filed therein prior to the termination of the interference or, upon a proper showing, within six months thereafter. The penalty for failure to so file is permanent unenforceability of all such agreements and the patent involved.

In the instant case, the agreements between the parties terminating the interference involving the CTS '285 patent were not filed before termination of the interference and no attempt for a proper showing of good cause was made during the six months thereafter. Accordingly, CTS' '285 patent and settlement agreements "A", "B", and "C" are permanently unenforceable.

STATEMENT OF FACTS

More specifically, by virtue of paragraph 2 of the aforesaid January 25, 1982, Judgment Order by this Court, this Court retained continuing jurisdiction over the subject matter in and parties to this action (a copy of the Order is attached hereto for convenience as Exhibit B). This Order was entered pursuant to agreements between the parties hereto to settle the litigation between them, including Interference No. 98,455 which involved the CTS '285 patent. Those settlement agreements resulted from oral face-to-face negotiations on November 23, 1981, which were subsequently reduced to writing on December 11, 1981, and executed by the parties shortly thereafter. Two additional agreements, a Settlement Agreement and a Li-

cense Agreement, were entered into by the parties in early January of 1982, pursuant to the initial agreement. The initial agreement, Settlement Agreement, and License Agreement, are commonly referred to as Settlement Documents "A", "B", and "C", respectively.

Because of the agreement made between the parties on November 23, 1981, defendants did not pursue any further appeals in the aforesaid interference. The Patent Office issued a paper (No. 206, a copy of which is attached hereto as Exhibit C) stating that because no further appeal had been filed it considered the interference "to be terminated as of the date of the Court action" (December 10, 1981, the date of the mandate of the United States Court of Appeals for the Seventh Circuit).

On February 2, 1982, CTS filed a document in the Patent Office advising that the litigation between CTS and Piher had been settled and that the validity of the patents involved had been upheld. This document further advised that a similar document entitled "Notification Of Settlement Of Civil Action Nos. 72 C 1891 and 76 C 1152" had been filed with the Board of Patent Interferences. The latter document likewise merely advised that the litigation had been settled and that the validity of the patents had been upheld. Attached to this document was a copy of the "Stipulated Consent Judgment In Lieu Of Accounting" that had been entered by Judge Grady on January 25, 1982, pursuant to the agreements between the parties. Although the Consent Judgment refers to "concurrently filed sealed documents A, B, and C [the Agreement In Principle, the Settlement Agreement, and the License Agreement]" they were not included with the copy of the Consent Judgment filed in the Patent Office.

Section 135(c) of Title 35, United States Code, in relevant part states that all agreements "made in connection

with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. . . . Failure to file the copy of such agreement or understanding shall render *permanently unenforceable* such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved". (emphasis added). Settlement Document B states:

> "WHEREAS, PIHER and CTS have been adverse parties in each of the following proceedings:
>
> * * *
>
> D. *English v. Heredero*, Interference proceeding No. 98-455 in the United States Patent and Trademark Office.
>
> * * *
>
> NOW, THEREFORE, in consideration of the mutual promises set forth herein, the parties agree as follows:
>
> 1. *Agreement In Principle.*
>
> The parties hereto agree to ratify and supplement hereby an Agreement In Principle attached hereto as Exhibit A dated December 11, 1981 and executed December 11, 1981 by their properly acting agents who executed on behalf of their respective principals said Agreement.
>
> 2. *Termination of Disputes.*
>
> The parties hereto agree to terminate each of the above-identified civil actions and administrative proceedings between the parties . . ."

Section 135(c) provides for a six-month "grace period" subsequent to the termination of the interference. During such period, upon "a showing of good cause for failure

to file within the time prescribed", the Commissioner of Patents and Trademarks may grant permission for late filing. Settlement Documents A, B, and C were not filed during the six months from December 10, 1981, through June 10, 1982.

JUDICIAL INTERPRETATION OF THE STATUTE

Public Policy Behind The Statute

The statute is punitive in nature and is designed to permit the United States Department of Justice to inspect agreements for possible antitrust violations. In *Moog Inc. v. Pegasus Laboratories, Inc.*, 521 F.2d 501 (6th Cir. 1975), the appeals court affirmed the district court's decision declaring a patent permanently unenforceable because of the failure to file a *supplemental* settlement agreement between the parties to the interference. The original settlement agreement was properly filed in accordance with Section 135(c) but, even though an agreement supplementing the original agreement was in fact filed with the Patent Office, it was not filed within the time prescribed by Section 135(c). In declaring the patent involved permanently unenforceable, the Sixth Circuit Court of Appeals held:

> "We hold that this statute [35 U.S.C. Section 135(c)] is designed to restrict monopolistic practice and (at least for purposes of this case) means just what it says and requires no interpretation" (521 F.2d, at 502).

The Court then went on to discuss the public policy behind the statute and quoted from Department of Justice comments during Senate considerations of the statute, as follows:

"The Supreme Court in holding a private interference settlement to be so inequitable as to preclude the enforcement of the resulting patent stated in *Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 815-816, 65 S.Ct. 993, 89 L.Ed. 1381 (1945):

> '* * * The possession and assertion of patent rights are "issues of great moment to the public" [citing cases]. A patent by its very nature is affected with a public interest. As recognized by the Constitution, it is a special privilege designed to serve the public purpose of promoting the "progress of science and useful arts". At the same time, a patent is an exception to the general rule against monopolies and to the right to access to a free and open market. The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope. The facts of this case must accordingly be measured by both public and private standards of equity.'

The purpose of this legislation is to make it more difficult for patent applicants to use an interference settlement agreement as a means of violating the antitrust laws. It seeks to accomplish this purpose by providing that no such agreement or understanding shall be enforceable unless all of its terms are in writing and filed prior to the termination of the interference proceeding. It is our view that this prohibition would not adequately deter violations of the antitrust laws. It is therefore suggested that the measure be amended to provide that parties to an interference settlement agreement shall be precluded from enforcing the resulting patent unless a copy of the settlement agreement has been filed with the Patent Office prior to the termination of the interfer-

ence. In order to protect innocent parties who inadvertently fail to file a copy of their settlement agreement, the Commissioner of Patents should be given the authority to entertain, at any time during the 6-month period subsequent to the termination of the interference, a petition by either party for leave to file a copy of the agreement, which petition may be granted on a showing of good cause for the failure to file within the time prescribed. Further, it is suggested that the bill should provide a right of action in the United States to obtain a civil penalty for failure to file a copy of an interference agreement.

S.Rept.No.2169, 87th Cong., 2d Sess., Reported in 2 U.S.Code Cong. & Admin.News, pp. 3286, 3289 (1962).

The Senate Report on Section 135 recited its central purpose:

The purpose of this bill is to amend the patent laws to require the filing in the Patent Office of agreements settling patent interference proceedings. When two or more applicants claim substantially the same invention as interference is declared in order to determine which applicant is entitled to priority. Interference proceedings may be terminated in a manner hostile to the public interest by using patent interference settlement agreements as a means of restricting competition. To make such a practice more difficult the bill requires the filing of such agreements in the Patent Office.

Id. U.S.Code Cong. & Admin.News, 1962 at p. 3286."

What Agreements Must Be Filed?

The statute says "Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference,

. . ." shall be filed in the Patent and Trademark Office. During the Senate hearings referred to hereinabove, the Commissioner of Patents at that time, David Ladd, was asked whether he thought the language of the bill was unclear regarding the types of agreements required to be filed. Ladd responded:

> "As to clarity, it seems to me it is quite clear. It is *all* agreements in contemplation or in settlement of interferences." (Senate hearings, *supra*, note 2, at page 16, emphasis added).

In the very recent decision of *United States of America v. FMC Corporation*, 514 F.Supp. 1166, 215 U.S.P.Q. 43 (E.D. Pa., Aug. 25, 1982) the court considered this question and stated:

> "Defendant makes much of the lack of potential antitrust significance in the unfiled agreements, ostensibly as a defense to its failure to file. *Whether defendant or I think the unfiled agreements have antitrust significance is irrelevant.* . . . The Statute's prophylactic purpose is furthered only if *all* agreements, regardless of their antitrust implications, are required to be filed." (215 U.S.P.Q., at page 50, note 3; emphasis added).

As to the "made in connection with or in contemplation of the termination of the interference" language of the statute, the *FMC* court construed that to imply that only agreements causally related to the termination of the interference need be filed. In *FMC*, the agreement setting the interference was properly filed but other agreements between the parties relating to similar patent rights in Canada and Latin America were not. The court held that such foreign agreements were not causally related to the termination of the interference and, therefore, need not be filed.

When Must The Agreements Be Filed?

The statute says that the agreements must be filed "before the termination of the interference". The statute also provides, however, for a six-month "grace period", to wit:

> "The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding."

The United States Patent and Trademark Office has consistently taken the position that the Commissioner cannot waive the statutory six-month filing requirement (*Nelson v. Bowler and Crossley*, 212 U.S.P.Q. 761 (1981); *In re Kruysman, Inc.*, 199 U.S.P.Q. 110 (1977); *In re Application Papers Filed October 26, 1965*, 152 U.S.P.Q. 27 (1966)). The Commissioner took this same position in *Esso Research of Engineering Company v. Brenner*, Commissioner of Patents, 165 U.S.P.Q. 486, and the Court of Appeals for the District of Columbia in that case refused to compel the Commissioner to accept the filing of the agreement after the termination of the six-month period.

ARGUMENT

Defendants submit that the Agreement In Principle (agreement "A"), Settlement Agreement (agreement "B"), and License Agreement (agreement "C"), clearly constitute agreements or understandings between the parties "made in connection with or in contemplation of the termination of the interference". As such, they should have been filed before December 10, 1981, the date the interference herein was terminated.

Having not filed them by that date, CTS was then under the obligation to show good cause for the failure to file them prior to December 10, 1981, and receive permission from the Commissioner of Patents and Trademarks to file the documents prior to June 10, 1982.

Having not filed any of these documents at any time, much less prior to June 10, 1982, the three agreements and the '285 patent are "permanently unenforceable" in accordance with the clear provisions of 35 U.S.C. Section 135(c). The legislative history and court decisions are uniform in their strict construction of the clear wording of the statute to fulfill its purpose.

As to the one document that CTS did file, a) it was filed after the termination of the interference, b) no attempt was made to show good cause for CTS' failure to file the document within the time prescribed by the statute, nor was any attempt made to obtain permission from the Commissioner to file the agreements within the six-month "grace period", c) the document was not filed in accordance with Section 135(c), and d) the document clearly does not constitute "all" agreements between the parties to this interference made in connection with or in contemplation of the termination of the interference.

CONCLUSION

The provisions of 35 U.S.C. Section 135(c) have not been complied with. Not one of the three settlement agreements which terminated the interference were filed with the Patent and Trademark Office. The language of the statute is clear, the relevant court decisions or [sic] uniform in the strict construction of the statute, and the penalty for failure to comply with the statute clearly was intended to be harsh in order to insure compliance with the statute.

Accordingly, defendants respectfully submit that the Court should modify its January 25, 1982, Judgment Order herein to conform to the fact that the CTS '285 patent and the Agreements "A", "B", and "C" are now permanently unenforceable. For convenience, a Proposed Judgment Order is attached hereto.

Respectfully submitted,

By: /s/ Richard R. Trexler
Raiford A. Blackstone, Jr.
Attorneys for Defendants

TREXLER, BUSHNELL & WOLTERS, LTD.
141 West Jackson Boulevard—Suite 3440
Chicago, Illinois 60604
Telephone: (312) 427-8082

January 14, 1983

APPENDIX G

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

CTS CORPORATION, *Plaintiff,*	)	
v.	)	Civil Action No. 76 C 1152
PIHER INTERNATIONAL CORPORATION, and PIHER SOCIEDAD ANONIMA, *Defendants.*	)	

STIPULATION

It is hereby stipulated by and between the parties to this litigation through their respective counsel that:

(1) Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 15, 16, 17, 18, 19, 21 and 22 of United States Patent No. 3,670,285, if valid, have been infringed by products sold by the Defendants in the United States subsequent to June 13, 1972 and referred to as PT Trimmers.

(2) The parties to this action agree to jointly move the Court to stay the proceedings in the above-entitled litigation until such time as decisions are rendered in Civil Action No. 72 C 1891, now pending in this Court and in Interference No. 98,455, now pending in the United States Patent and Trademark Office.

It is further stipulated by and between the parties to this litigation through their respective counsel, this Honorable Court consenting, that:

(3) Should CTS Corporation prevail in a decision which has become final on the "on sale" issue in the aforesaid Civil Action No. 72 C 1891 and the Party English prevail in a decision which has become final in the aforesaid Interference, a judgment be entered by this Court that the Defendants have infringed the claims of U.S. Patent No. 3,670,285 enumerated in paragraph 1 hereof, and that those claims are valid.

(4) Should the Defendants prevail in a decision which has become final on the "on sale" issue in Civil Action No. 72 C 1891 or if Heredero prevails in a decision which has become final in the aforesaid Interference, the Court should dismiss this action with prejudice, each party to bear its own costs.

MASON, KOLEHMAINEN, RATHBURN & WYSS

By /s/ Walther E. Wyss
One of the Attorneys for Plaintiff
20 North Wacker Drive—Suite 3200
Chicago, Illinois 60606
Telephone: (312) 346-1677

Dated:
Dec. 7, 1976

OLSON, TREXLER, WOLTERS, BUSHNELL & FOSSE, LTD.

By /s/ Raiford A. Blackstone, Jr.
One of the Attorneys for Defendant
141 West Jackson Boulevard
Chicago, Illinois 60604
Telephone: (312) 427-8082

Dated:
Dec. 7, 1976

APPENDIX H

Paper No. 206

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Mailed
Nov. 21, 1981
Board Of Patent
Interferences

Interference No. 98,455

English

v.

Heredero

Civil Action No. 81-1672

Receipt is acknowledged of a Certified Copy of the Mandate of the United States Court of Appeals for the Seventh Circuit affirming the judgment of the District Court, which affirmed the decision of the Board of Patent Interferences (Paper No. 182).

No further appeal having been filed, in view of the aforementioned action this interference is considered to be terminated as of the date of the court action and the files are being returned to the Examining Group for appropriate action by the Primary Examiner.

/s/ Charles R. Houpe
Clerk, Board of Patent Interferences
703/557-3550

CRHoupe/pab